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IN THE

SUPREME COURT OF THE UNITED STATES

October Term, 1977

AVANT INCORPORATED,

Petitioner,

v.

POLAROID CORPORATION,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

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RELIEF SOUGHT

Petitioners pray that a writ of certiorari issue to review the judgment and opinion of the United States Court of Appeals for the First Circuit entered in this action on March 21, 1978 (No. 77-1349).

OPINIONS BELOW

The opinion of the District Court dated June 8, 1977, is reported at 441 F. Supp. 898, and appears in Appendix A. A notice of appeal to the United States Court of Appeals for the First Circuit was docketed August 3, 1977. The opinion of the Court of Appeals dated March 21, 1978, affirming the opinion of the District Court is attached as Appendix B (—F.2d—).

JURISDICTION

The final judgment of the Court of Appeals was entered on March 21, 1978. The jurisdiction of this Court is invoked pursuant to 28 U.S.C., Section 1254(1). The jurisdiction of the District Court is invoked pursuant to 28 U.S.C., Section 1338.

QUESTIONS PRESENTED

1. DEPRIVATION OF FAIR TRIAL

Was Petitioner deprived of due process by the refusal of the Court of Appeals to grant a new trial in view of Rule 1 of the Federal Rules of Civil Procedure requiring proceedings in the District Courts to be conducted to secure the "just, speedy, and inexpensive determination of any action" where:

a. the District Court handed down an opinion one year after an abbreviated trial of less than two days so that Petitioner lost the benefits of a trial;

b. substantial portions of the trial record most favorable to Petitioner were missing from the court records;

c. the trial judge stated in open court (unrecorded) during the trial before the first recess that he was leaning toward Respondent?

2. NEW REQUIREMENT OF TOLERANCES (E.G. ENGINEERING DETAILS) IN PATENTS

Has the Court of Appeals for the First Circuit acted inconsistently with other Circuits by requiring a patent to fully teach all engineering details required to produce a finished commercial product, rather than to teach skilled workers in the art how to

produce the product, taking into account their extensive knowledge of the art; and has the First Circuit virtually nullified all patents subject to litigation in the First Circuit, including those of Respondent, that omit engineering details?

3. IMPROPER REQUIREMENT OF SUBJECTIVE CRITERIA

Has the Court of Appeals for the First Circuit acted inconsistently with other Circuits in requiring a patent owner to show that persons skilled in the art, competing with the patent owner, would have thought, i.e., using prior subjectivity, that a key feature of the invention would not have produced a proven beneficial result, where such persons never adopted the key feature, with the prior art under their very nose for years, until they copied it from the patent owner?

4. IMPROPER CONVERSION OF A PROCESS INTO A PRODUCT

Have the Courts below ignored Title 35 U.S.C. 101 in equating a process with a product, notwithstanding the specific statutory provisions that provide for process inventions which are separate from product inventions?

5. ELIMINATION OF SYNERGISTIC CONGRUENCY

Has the Court of Appeals deprived the Petitioner of due process by

insisting that the invention does not display synergy and simultaneously refusing to accept the specific congruency requirement of the patent that makes the synergy possible?

6. SIMPLICITY SHOWS NON-OBVIOUSNESS WHERE THERE IS LONG-FELT NEED

Has the Court of Appeals erred in finding no significance in the alleged simplicity of the invention in view of the long-felt need for the invention, which in the case of a simple invention would have resulted in almost its immediate discovery if it were, in fact, obvious?

7. CRUCIAL AND CLEARLY ERRONEOUS FACT FINDING BY THE COURT OF APPEALS

Has the Court of Appeals deprived Petitioner of due process by making the completely unsupported and erroneous finding of fact that the invention could not be practiced without equipment that was not developed until after the invention when it was demonstrated at trial that the invention could be practiced with the earliest prior equipment? Has the Court of Appeals further deprived Petitioner of due process by relying on the unsupported and clearly erroneous finding to show that the invention is not patentable?

8. FAILURE TO GRASP TECHNICAL SUBJECT MATTER

Have the Courts below failed, despite the alleged simplicity of the invention, to grasp the technical subject matter in suit in view of their reliance on a reference (Dunn) that is technologically alien to the invention, the making of unsupported finding of fact (Cf. Question 6) by the Court of Appeals and by numerous references to molding (18 instances) when the invention is the very opposite of molding?

9. DEPRIVATION OF CRUCIAL EVIDENCE

Has the Petitioner been deprived of crucial evidence or witnesses in the District Court in view of the limitation of the trial to a period of less than two days?

10. RELIANCE ON A SECRET PATENT REFERENCE

Has Petitioner been deprived of due process by the ruling of the Courts below that the invention is obvious in view of a patent reference (Dunn) that was not public knowledge at the time the invention was made?

11. DEPRIVATION OF FAIR PROCEDURE

Has Petitioner been deprived of due process by the refusal of the Courts below to consider crucial

Rule 36 Admissions that were made by Respondent solely because of Petitioner's failure to move them into evidence during the last phase of the trial where Petitioner was seeking to expedite the litigation, as the time deadline of the trial judge approached, by agreeing that the parties could designate deposition testimony in lieu of having it read into the Record, and thus assuming that the same condition would apply to the Rule 36 Admissions?

BRIEF STATEMENT OF THE CASE

Petitioner Avant Incorporated (Avant) brought an action under 28 U.S.C. 1338 against Polaroid Corporation (Polaroid) alleging infringement of the United States Letters Patent No. 3,679,512, issued July 25, 1972, to plaintiff as the assignee of the patentee.

The patent in suit describes a process or method for fabricating a laminated data card. The District Court in an opinion dated June 8, 1977, held that the patent in suit was invalid under 35 U.S.C. 103 in view of a patent to Dunn, which was not a matter of public knowledge at the time the invention was made, and a prior use of plastic envelopes having non-congruent edges, i.e., not "superposable so as to be coincident throughout."*

While extensive objective evidence was introduced to support plaintiff's position that the patent was not obvious to the ordinary worker in the art, this evidence was ignored by the District Court. For example, plaintiff demonstrated that the very users of the prior art non-congruent plastic envelopes experienced a long-felt need for the invention and yet with the prior

* WEBSTER'S THIRD NEW INTERNATIONAL DICTIONARY, 1961

art under their very nose for years, missed the invention, including Respondent's key witness.

After plaintiff introduced the invention into the marketplace, the invention was copied by the very same users of the prior art, who then extolled the benefit of invention. Shortly thereafter, Polaroid Corporation, along with many others in the industry, also copied the invention from plaintiff.

Both the District Court and the Court of Appeals held that there was commercial success, but that plaintiff was not entitled to the benefits which flowed from the invention because the patent did not teach sufficient engineering details to produce a perfect commercial product. One such detail relates to tolerances, with the District Court stating on Page 11 of its opinion that "The patent in suit does not specify tolerances relating to congruency..." and the Court of Appeals stating on Page 6 of its opinion that the patent does not "...spell out the degree of congruency--the tolerances--required...."*

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*To ask how "congruent" is "congruent" is like asking how "black" is "black."

REASONS FOR QUESTION #1
(DEPRIVATION OF FAIR TRIAL)

It is respectfully submitted that the actions of the District Court, condoned by the Court of Appeals, have adversely affected the substantial rights of Petitioner and deprived it of a fair trial.

An abbreviated trial was conducted on June 7 and 8, 1976, wherein Petitioner's president testified with respect to the operation of various devices in the prior art and with respect to the differences between the invention of the patent in suit and the prior art. A disinterested third party witness also testified as to the same subject matter and to the effect that the invention was unobvious to him. A witness for Respondent also testified during the abbreviated trial, and acknowledged by contrast with the invention, that the prior art samples were non-congruent.

The actual trial time was about 1-3/4 days, owing to the trial judge's hearing with respect to a motion in a criminal case. One year later, on June 8, 1977, the trial judge rendered his Opinion. This patent litigation involved the comprehension of detailed points of technology, which were presented to the Court in the form of exhibits and testimony. Additionally, because the parties were informed that the judge desired the trial to last no

more than two days, Petitioner, in this non-jury trial, was limited in the material it could present without coming in conflict with the desires of the judge to limit the trial to two days.

Under these circumstances, how can it be concluded that Petitioner received a fair trial since it is submitted that it would be virtually impossible for the trial judge (and a new judicial clerk) to remember the testimony, the creditability of the witnesses, and the details of the devices demonstrated in the courtroom a year before handing down his Opinion? Why constrain a trial to a limited two-day period if the Opinion cannot be rendered within a reasonable time thereafter? It is respectfully submitted that Petitioner should be entitled to a new trial before another judge on this ground alone, since it was, in effect, deprived of the benefits of a fair trial.

Furthermore, substantial portions of the trial record, most favorable to the Petitioner, were missing from the court records, which was discovered by Petitioner during compilation of the Appendix on appeal. These portions set forth the cross examination of Respondent's sole witness, and it is respectfully submitted that the absence of this part of the record deprived Petitioner of the benefits of a fair trial. This is particularly true since the one-year delay in rendering the opinion should require the judge to review the testimony.

Furthermore, the trial judge stated in open court before the first recess in the trial that he was "leaning toward Polaroid." This statement alone is at variance with the Federal Rules and the U.S. tradition of justice which require the appearance of even-handed impartiality.

REASONS FOR QUESTION #2
(NEW REQUIREMENT OF TOLERANCES
[E.G. ENGINEERING DETAILS] IN PATENTS)

It has been widely reported that innovation and research have substantially declined in the United States during the last several years. Competition from innovative countries, such as Germany and Japan, which, by contrast with the United States, have strong patent systems, has made severe economic inroads again the United States in both foreigh and domestic markets. The result is that this country has a serious trade deficit, which, for example, was 3.65 billion dollars in March, 1978, and 5.46 billion in February, 1978.

The United States patent system is mandated "To promote the progress of science and useful arts...."* To do so, it must stimulate capital investment in innovation and research. If the fruits of innovation and research are not protectable by the patent system, it becomes extremely difficult to raise capital.

Our society is severely penalized when invention is not stimulated "... by securing for limited times to authors and inventors the exclusive rights to their respective writings and discoveries."* A patent is not a stilitifying monopoly but rather an invigorating competitive incentive to promote

*U.S. Constitution, Article I, Section 8, clause 8

progress as our Constitution rightly states.

Furthermore, the survival of small companies, such as Petitioner, is often based upon effective patent protection of its innovative products. Without such protection, a small business generally cannot survive in the face of tremendous marketing power. Indeed, Respondent's founder and chairman, Edwin Land, has acknowledged the role that patents have played in the success of his company. He stated at the Polaroid Corporation annual meeting in April, 1977: "The only thing that keeps us alive is our brilliance. The only way to protect our brilliance is our patents." The First Circuit has now jeopardized all patents by requiring that they include "tolerances."

A patent speaks to the skilled artisan and not to the layman, as plainly indicated by 35 U.S.C. 112, C. 950, Sec. 1, 66 Stat. 798 (Appendix D). The inventor is faced with filing his patent application as early as possible since the patent law often requires it. See 35 U.S.C. 102, C. 950, Sec. 1, 66 Stat. 797 (Appendix D). Early filing means that the patent issues much earlier so that others may build upon the concepts therein, which become disseminated widely to all, in sharp contrast with maintaining the matter a trade secret. Furthermore, even if it were possible to include extensive engineering details in a

patent application when filed, to do so would be a waste of time and resources because a patent is directed to those skilled in the art, in contrast with laymen in the art. The requirements for engineering details, such as tolerances, do not exist in any modern patent office, such as the German and Japanese patent offices, nor in any other country. Furthermore, millions of U.S. patents do not meet this novel criteria. The Court of Appeals below, in effect, held that the patent was fatally defective due to the lack therein of such engineering details, since it failed to distinguish between severe and miniscule oozing of adhesive in Petitioner's inventive product. The Petitioner concedes there was some slight oozing of adhesive from the edges of its early prototype embodiments of the invention, which is undesirable in a finished commercial product. As the record clearly shows, this slight drawback is of minor importance, and in fact, ironically, exists today in Respondent's products embodying the invention sold in the marketplace.

In summary, by requiring the inventor to set forth engineering details relating to the right combination of heat, materials, machine, and tolerances, which are unnecessary and not required by either the case law, the statutes, or the skilled artisan to whom the patent is directed, the Court of Appeals has established a criteria which in effect invalidates in the First Circuit most currently issued patents, including those of Respondent.

REASONS FOR QUESTION #3 (IMPROPER REQUIREMENT OF SUBJECTIVE CRITERIA)

The Court of Appeals has imposed a further unwarranted requirement on the United States patent system by requiring the patent owner to prove that workers in the art would not have thought that the invention would produce the beneficial results obtained by it. This Court in Graham v. John Deere Co. of Kansas City, 148 USPQ 459, 467, 474; 383 U.S. 1, 17, 26; 86 S. Ct. 684 (1966); directed the lower courts to examine objective (in contrast with subjective) evidence in connection with whether the invention, which produced the benefits, would be obvious to the ordinary worker in the art. These objective inquiries include the following "...commercial success, long-felt but unsolved need, failure of others..." (id at Page 17). Petitioner proved that there was a long-felt need for the invention; that workers in the field failed to recognize and adapt the invention with the prior invalidating art under their very nose, and after the invention was introduced into the marketplace by the Petitioner, that they thereafter copied it. In this case, the very users of the prior art, applied to invalidate the patent, felt the need to attain the benefits of the invention, and yet completely missed the invention, until it was introduced by the Petitioner, and the invention was thereafter copied by such users of the prior art, Polaroid Corporation, and the entire industry. Both the District Court and

the Court of Appeals erroneously swept these objective facts aside since the benefits proven by the Petitioner did not result in what the lower courts considered to be a finished commercial product. By its decision, the Court of Appeals holds that Petitioner must prove a subjective state of mind of persons skilled in the art: namely, that plaintiff did not prove that workers in the field would ever had thought that the key feature of the invention would not produce the above-stated benefits. See lines 1-4 of the second paragraph, Page 5, of the Opinion of the Court of Appeals reported in the F. Supp. Petitioner respectfully submits that this completely uncalled-for requirement creates an intolerable burden on the inventor.

In summary, in connection with Question #3, it is manifestly unjust for the Court of Appeals to ignore the objective criteria set forth by this Court in Graham, supra, and numerous other cases and to superimpose an additional novel subjective "state-of-mind" requirement for invention, which amounts to an intolerable burden on the inventor, and which is without basis in any patent stature or case law. Such a requirement is also contrary to 35 U.S.C. 103, C. 950, Sec. 1, 66 Stat. 798. In Graham, supra, this Court stated that 35 U.S.C. 103 was intended to abolish the (subjective) "flash of genius" test.

REASONS FOR QUESTION #4 (IMPROPER CONVERSION OF A PROCESS INTO A PRODUCT)

It is to be emphasized that the invention in suit relates to a method and not merely to a group of elements combined to form a product. Method inventions, as opposed to product inventions, are one of the classes specifically authorized by statute. 35 U.S.C. 101 specifically provides:

> "§ 101. Inventions patentable
>
> "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title." (emphasis added)

Section 100(b) defines a "process" as including a "method" as follows:

> "§ 100. Definitions
>
> "When used in this title unless the context otherwise indicates--
>
> "(a) The term 'invention' means invention or discovery.
>
> "(b) The term 'process' means process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter or material."

The method of the invention requires the face-to-face heat lamination of congruent sheets that are maintained in congruency by accurately positioned heat seals. The method includes the steps of widely separating the sheets and accurately positioning and gripping an insert against the seals.

The invention is thus in sharp contrast with the roll and platen methods of heat lamination in the prior art, where grossly oversized and imprecise pairs of elongated plastic rolls or sheets were laminated first and then laboriously trimmed or die-cut by the end user to produce a finished product to achieve congruency.

The invention achieves the reverse: Trimming first, and then heat lamination afterwards. Fabrication is rapid and easy.

Notwithstanding the specific requirements of 35 U.S.C. 101, the District Court treated the invention as a combination of elements. The Court of Appeals agreed (Page 3 of its Opinion) with the reasons developed in the Opinion below. It is to be noted that other Courts have recognized the basic distinction between a method on one hand, and a combination of elements on the other hand. Cf., Federal Sign & Signal Corp. v. Bangor Punta, Inc., 357F Fed. Supp. 1222, SDNY (1973).

REASONS FOR QUESTION #5 (ELIMINATION OF SYNERGISTIC CONGRUENCY)

The Court of Appeals noted (Page 5 of its Opinion) that in the case of the invention "congruency" was said to have produced a "surprising result" in that molten adhesive would not ooze, but for reasons not fully understood, stayed put. This statement sets forth only partially Petitioner's position. Petitioner acknowledged that in some situations, even with congruency, it would be possible to have an outflow, but it is readily removed, e.g., with a fingernail or by wear, so that a commercially acceptable product could be produced without the need for post-lamination trimming. This is by complete contrast with the non-congruent envelopes of the prior art in which the outflow of adhesive produced a comingling with untrimmed edges that required post-lamination trimming in order to achieve a commercially acceptable product.

The Court of Appeals concluded that there was nothing surprising about Petitioner's result because the patented envelopes will ooze unless the correct combinations of heat and materials are used. Yet, as noted above, the kind of ooze that results is readily eliminated. The surprising consequence of the congruency is that no post-lamination die-cutting or trimming was needed. The congruency requirement that makes this possible is fully set forth in the patent and was understood by ordinary

workers in the art, including those of Respondent. Yet in the face of the express language of the patent, the Court of Appeals said that when the Petitioner requires congruency it really doesn't mean it.

REASONS FOR QUESTION #6 (SIMPLICITY SHOWS NON-OBVIOUSNESS WHERE THERE IS LONG-FELT NEED)

The Court of Appeals conceded that the greatest inventions may be simple and then dismissed the significance of simplicity by concluding that many non-patentable devices are simple also.

In the case of the invention in suit, however, the alleged simplicity combined with need establishes non-obviousness. The invention provides something that has been needed by the art since the advent of the lamination of plastic sheets by heat and pressure in the early 1930's. Yet the invention was not made until the mid 1960's. It was demonstrated by Respondent at trial that the invention could be practiced on the platen press, i.e., of the type that dated back into the 1930's. If an invention is needed and it is simple, one must conclude that the invention would have been made in the 1930's instead of the 1960's if it had, in fact, been obvious.

REASONS FOR QUESTION #7 (CRUCIAL AND CLEARLY ERRONEOUS FACT FINDING BY THE COURT OF APPEALS)

As noted above in connection with the reasons for granting the petition with respect to Question #6, the invention could be practiced on the earliest equipment developed for heat lamination. Yet the Court of Appeals specifically found to the contrary (Page 4 of its Opinion) that the platen press was replaced by the "chip bonder" with the result that envelopes could then be laminated without distortion. The Court then concluded that once this development took place, "...invention was not required to finish off the pouch earlier rather than later" (Page 4 of its Opinion). Thus the Court of Appeals not only made a clearly erroneous and unwarranted finding of fact, it improperly used that erroneous and unwarranted finding of fact to hold that no invention was required to produce Petitioner's result.

In fact, during the depositions and trial, four distinctly different types of laminating machines were successfully used to practice the invention, conclusively demonstrating its independence of the latest type of machine, upon which the Court below based the following syllogism:

1. The invention requires a laminating machine.

2. The latest version of laminating machine successfully practiced the invention.

3. Therefore, the latest version of laminating machine is "...the linchpin of Avant's commercial success." (Page 6)

While it is true that the invention requires a laminating machine, it can be practiced in any, not just the latest, such machine. The invention became a success because it avoided the need for post-lamination trimming. The latest machine merely provides a better way of achieving the same result that also can be achieved using the earliest 1930's machines.

It is to be noted that the Court's erroneous insistence that the latest machine made the invention a success is completely at variance with its insistence that the invention would have been obvious in the light of the secret and non-analogous Dunn reference where the express purpose is to avoid the use of any machine.

REASONS FOR QUESTIONS #8
(FAILURE TO GRASP TECHNICAL SUBJECT MATTER)

Despite the express method language of Petitioner's claim, the Court of Appeals concluded that the invention is simply a convenient laminating envelope (Page 5), as did the District Court.

At the same time, the Court of Appeals throughout its Opinion referred to molding machines (Page 3), molding processes (Pages 3, 4, 6), molding art (Page 4, two instances; Page 5), molding technique (Pages 4, 5), and molding or mold in general (Page 2, Page 4, three instances; Page 5, four instances; Page 6) for a total of 18 references in six pages. Molding has nothing whatsoever to do with lamination and the invention and, in fact, is the opposite of lamination. Molding involves "a cavity in which a substance is shaped" (WEBSTER'S SEVENTH NEW COLLEGIATE DICTIONARY, 1971). Laminating in accordance with the invention involves no use of a cavity but rather the bonding of material under heat and pressure.

In addition, the Court of Appeals and the District Court found a Dunn patent to be a pertinent reference. The invention, however, is in marked contrast with the persistently sticky, pressure-sensitive adhesive envelope of the Dunn patent which is intended to avoid the heat activation required for

the invention. It is well understood by those skilled in the art that pressure-sensitive adhesives and heat-activatable adhesives pose entirely different problems.

It is also to be noted that the Dunn reference was in a cross-reference class that was listed by the examiner in his search notes, but was not cited because its technology is so alien to the technological problems involved in face-to-face heat lamination.

REASONS FOR QUESTION #9
(DEPRIVATION OF CRUCIAL EVIDENCE)

Since the District Court limited Petitioner to a trial period of less than two days, Petitioner was unable to introduce, for example, the testimony of Dunn (upon whose patent the Courts' Opinions rely). He would have testified that his invention involves a technology which is not properly combinable with the prior art bag pouches and that it would not have been obvious to him to make such a combination. Petitioner was also deprived of an opportunity to introduce other testimony as to the non-obviousness of the invention.

REASONS FOR QUESTION #10
(RELIANCE ON A SECRET PATENT REFERENCE)

35 U.S.C. 103 must be construed in a manner to uphold its constitutionality and preserve the rights of the inventor (U.S. Constitution, Article 1, Section 8, clause 8). While the Court has previously interpreted the statute* as permitting the combination of a reference (Dunn) that was not publicly known at the time the invention was made with one or more other references, such a construction is contrary to the mandate of the Constitution because it does not secure to the inventor the exclusive right to his discovery. Instead, it permits the rights of the inventor to be defeated on the artificial basis of constructive notice of a reference that was maintained in secrecy in the U.S. Patent Office until many years after the invention.

This is unlike the situation under 35 U.S.C. 102, where a prior anticipatory reference can validly bar a subsequent application on the identical subject matter. In this case the trial court specifically found that 35 U.S.C. 102 does not apply.

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*Hazeltine Research v. Brenner, 382 U.S. 252 (1965)

REASONS FOR QUESTION #11
(DEPRIVATION OF FAIR PROCEDURE)

In its Rule 36 Admissions, Respondent made admissions that are believed to clearly demonstrate the non-obviousness and significance of the invention, as well as demonstrate the blatant copying of the invention by Respondent after it had groped for years and failed to find a satisfactory solution on its own.

These Admissions were excluded because Petitioner did not place them in evidence before it rested at the end of an "expedited" two-day trial.

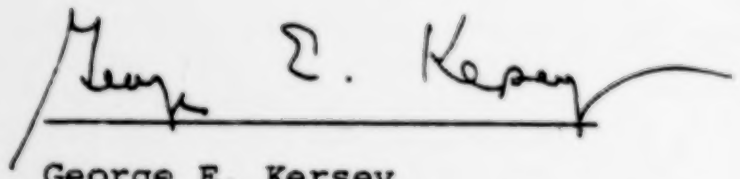
As stated in Moore's Federal Rules Pamphlet, 1975, on Page 730:

> "The new provisions give an admission a conclusively binding effect, for purposes only of the pending action, unless the admission is withdrawn or amended. In form and substance a Rule 36 admission is comparable to an admission in pleadings or a stipulation drafted by counsel for use at trial, rather than to an evidentiary admission of a party. Louisell, Modern California Discovers § 8.07 (1963); 2A Barron & Holtzoff, Federal Practice and Procedure § 838 (Wright ed. 1961). Unless the party securing an admission can depend on its binding effects, he cannot safely avoid the

> expense of preparing to prove the very matters on which he has secured the admission, and the purpose of the rule is defeated. Field & McKusick, Maine Civil Practice § 36.4 (1959); Finman, supra, 71 Yale L.J. 371, 418-426; Comment, 56 Nw. U.L. Rev. 679, 682-683 (1961)."

It is to be emphasized that under the particular circumstances of the trial in Petitioner's case, with emphasis on concluding the proceedings in an abbreviated two-day period, with agreement that the Parties could designate deposition testimony in lieu of having it read into the Record, Petitioner assumed that the Rule 36 Admissions could also be designated. Their exclusion in the face of these circumstances is inconsistent with "substantial justice" and constitutes "Harmless Error" under Rule 61 of the Federal Rules of Civil Procedure (Appendix E).

Respectfully submitted,



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APPENDIX A

UNITED STATES DISTRICT COURT
DISTRICT OF MASSACHUSETTS

AVANT INCORPORATED

v.

CIVIL ACTION
NO. 72-3892-F

POLAROID CORPORATION

OPINION

June 8, 1977

FREEDMAN, D.J.

Pursuant to an Order of this Court dated March 29, 1976, this matter was tried without a jury on June 7 and 8, 1976, on the limited issue of validity of the patent involved herein. The parties thereafter filed extensive briefs and proposed findings of fact and conclusions of law. After careful consideration of the evidence and pertinent authorities, the Court hereinafter sets forth its findings in accordance with Rule 52(a) of the Federal Rules of Civil Procedure.

This is an action brought under 28 U.S.C. § 1338 by Avant Incorporated (Avant) against Polaroid Corporation (Polaroid) alleging infringement of

United States Letters Patent No. 3,679,512 (the '512 patent),[1] issued July 25, 1972 to plaintiff as the assignee of the patentee Frederick W. Macone.

Avant is a corporation existing under the laws of the Commonwealth of Massachusetts. Defendant Polaroid is a Delaware corporation having its principal corporate offices and a regular and established place of business in the Commonwealth of Massachusetts.

Polaroid denies that it has infringed the '512 patent and counterclaims, inter alia, for a declaratory judgment that the '512 patent is invalid, under 35 U.S.C. § 102, because of anticipation of prior use, knowledge, patenting, and sale; under 35 U.S.C. § 103, because of the obviousness of the '512 invention to a skilled mechanic presumed to know the prior art; and, under 35 U.S.C. § 112, for failing distinctly to claim and adequately to describe the subject matter of the '512 patent.

The patent in suit describes a method for fabricating a laminated data card. Essentially, the method involves two outer plastic sheets which are joined by elongated spot welds. These

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[1]The '512 patent has been reproduced in Appendix B to this opinion.

"welds or seals couple and maintain the outer sheets in a congruent relationship," and at the same time "act as nests to receive and properly orient the inner data card which may be inserted in a second or so." The essence of the claimed invention, therefore, is found in the features of the envelope which is created by the joining together of the two plastic sheets, and which is to be used in a manner to take advantage of its features. More specifically, as enumerated in Claim 1 of the '512 patent, the "coupling means" of the envelope maintain the outer sheets in a congruent face-to-face relationship with each other, permit wide separation of the coupled sheets, and are positioned with respect to the edges of the coupled sheets so as to permit proper location of an edge of a data-bearing sheet which has been inserted between the coupled sheets and abutted against the coupling means. Claim 1 further specifies that the method enables a data-bearing card to be inserted easily and rapidly between the outer sheets and, once inserted, to be gripped thereby, before the sheets and the data-bearing sheet are laminated together by the application of heat. Claim 2 of the patent in suit specifies that the coupling means is formed by heat sealing the outer plastic sheets together at widely separable portions so as to provide for accurate alignment of the edges of a data-bearing sheet in relation to the coupled outer sheets.

It is evident from a reading of

the '512 patent that it does not claim or teach the use of the claimed method described above in relation to particular bonding machines, laminating materials, or variables of temperature, period of heat application, or pressure. Thus, in its determination of the validity of the patent, this Court is restricted to a consideration of the character of the envelope and the method of fabricating the laminated data card as described in the patent itself.

In order to save time at trial, the Court ordered that, following trial, the parties submit (1) any objections they might have to placing in evidence exhibits that had not been so admitted during trial, and (2) designations and counter-designations of deposition testimony to be included in the record of the case. In their efforts to comply with the Court's wishes, the parties filed, among other things, such objections and designations as were requested and, in doing so, also partook in a protracted written argument as to the propriety of each other's submissions. Because these objections and designations go directly to what the Court is to consider in its determination of the issues in this case, it is appropriate to deal with them now.

The Court admits as part of the record all the portions of deposition testimony that both plaintiff and defendant designated to the Court following trial. This includes all portions designated by Avant in its filing with this Court dated July 7, 1976, and all

those designated by Polaroid in its filings dated June 17, 1976, and July 23, 1976.

The Court has considered all the exhibits presented at the time of trial, and the objections, if any, to their being admitted into evidence. The determination as to each of them is expressed in Appendix A to this opinion.

In addition to filing the above-mentioned objections and designations, Avant submitted to the Court designations for the record of various stipulations it claimed had been entered into with Polaroid prior to trial and designations of Rule 36 admissions that it claimed have been made by defendant. It is the Court's feeling that at the conclusion of the trial concerned herein, both sides rested their case, subject only to the submission of the objections, designations, and counter-designations already discussed. Had Avant wished to place into evidence such stipulations and admissions, it should have done so during the presentation of its case before it rested. Those designations are therefore disallowed.[2]

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[2] Because the stipulations and Rule 36 Admissions which Avant submitted have been excluded from the record, the Court does not reach a decision as to their validity. I would comment, however, that Polaroid raises serious question as to whether the pretrial

(continued on page 33)

The Patent Act of 1952 specifically sets forth the conditions of patentability in three sections. Codified as sections 101, 102, and 103 of Title 35, they make it clear that patentability is dependent upon three conditions: novelty, utility, and non-obviousness. Because of the nature of the language of sections 102 and 103, both involved in the instant case, a defense based upon section 103 is broader than one which relies upon section 102, it would seem appropriate to begin with a discussion of section 103.

35 U.S.C. § 103 provides:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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stipulations Avant wished to designate were actually agreed upon and whether all the requests for admissions could be deemed admitted under the given circumstances.

As stated by the Supreme Court in Graham v. John Deere Co. of Kansas City, 383 U.S. 1 (1966),

> [w]hile the ultimate question of patent validity is one of law, A. & P. Tea Co. v. Supermarket Corp. [340 U.S. 147] at 155, the § 103 condition, which is but one of three conditions, each of which must be satisfied, lends itself to several basic factual inquiries. Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.

Id. at 17. Thus, as made clear by the above language, in a determination of patentability of the invention involved in the present case, as regards section 103, the background of that invention and the prior art in the field of data card lamination must be considered.

In the field of data card lamination, three general types of devices have served as providers of heat in the bonding process: the platen press, the roll laminator, and the chip bonder. Although the '512 patent does not concern or specifically refer to any particular type of laminator, an overview of the above devices is helpful in

understanding a discussion of the types of bonding systems and envelopes that were used in the laminating field prior to the issuance of that patent. The platen press, as described at trial by Roger J. Kuhns, president of Avant, came into being around 1930. It consisted of two parallel plates which were heated and which laminated a sandwich of two sheets of thermal setting plastic and an insert by a process of heat, fusion, and cooling while under pressure. The roll laminator was apparently introduced into the trade in the mid-1950's and, according to Kuhns, proved to be more successful than the platen press because of its relative speed in laminating. This newer type of laminator also employed heat in its laminating process, but, unlike the platen press, made use of continuous rolls of plastic that were fed through the device and could at appropriate times have inserts placed between them so that, following the heating process, the type of sandwich already discussed was produced. The chip bonder, the most recent device of the three, came into use in the mid-1960's. This type of laminator was designed to receive an insert and an envelope of predetermined size (a "chip"). It achieved commercial success, due primarily to its speed in bonding relative to the earlier types of machines.

As briefly described above, in platen lamination, a data card is inserted between oversized sheets of plastic and heated in the press. Early

platen laminations were produced by the use of separate sheets of plastic. The platen method was effective in producing laminated cards, but was not without its problems. Besides being slow and cumbersome, the original method of using separate outer sheets could lead to operator error, since opposite faces of those sheets were heat sensitive adhesive and non-adhesive. If placed into the press so that the adhesive face was improperly facing away from instead of toward the insert being laminated, the finished product was not successfully laminated and the press was subjected to the messy excess flow of adhesive material. To avoid this type of error, the outer plastic sheets were eventually tacked together so that the sides with the heat sensitive adhesives always faced the proper direction. The result was a bag-like pouch into which an insert was placed prior to lamination.[3]

Although these bag pouches apparently eliminated the operator error associated with the use of separate outer sheets, the platen method remained slow and the cards laminated in the platen press, depending upon their desired size and intended use, often needed to be trimmed of excess plastic.

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[3]Whether there was any significance to such tack welds other than to prevent such operator error in placement of the sheets is a matter with which the parties are in disagreement. That issue will be discussed later.

Because the roll lamination method proved to be faster, the platen press became for the most part obsolete and was largely superseded by the roll laminator around 1960. Nevertheless, the latter type of machine, while faster than the platen press, had disadvantages common to the platen method - waste of plastic material and the frequent need for post-lamination trimming.

Another approach to data card lamination was taken in a 1964 patent application filed by Donald N. Decof. As taught by the Decof patent, U.S. Patent No. 3,388,661, a pouch of predetermined size was made with three sides closed and one side (the minor dimension edge) open. Face-to-face heat lamination was not employed. Rather, after a data card had been inserted, the fourth side of the pouch was sealed and embossed with a distinctive raised pattern which would usually identify the organization using the identification card. Thus the card, not bonded to the pouch itself, "floated" within. Briefly, the Decof patent claimed a card receptacle as described above in which the sealed area defined a pocket utilized to position an identification sheet and which served as a tamperproof, counterfeit deterrent identification device.

It was in the mid-1960's that the patent in suit was conceived and eventually reduced to practice. According to Avant, the '512 patent was the

result of its efforts to create a method for producing laminated data cards that would provide security, minimize waste of plastic, reduce labor time, and eliminate costs of post lamination trimming devices.

About the same time that Avant conceived and put into practice the envelope which was the subject of the '512 patent, Polaroid began to produce an envelope named the Polapouch. That pouch had a construction similar to that of the Decof pouch. As in the method taught by the Decof pouch, a data card was placed in the Polapouch, and then a fourth edge was sealed, leaving the insert to float within. Several years later, about 1969, Polaroid produced another type of laminate envelope referred to as a dual bond. The dual bond laminate made use of pressure sensitive adhesive and was the subject of a patent filed by Robert A. McVoy and Ronald R. O'Connor in 1972 (U.S. Patent No. 3,827,726) and apparently fashioned after the teachings of a patent filed by Lyman D. Dunn in 1966 (U.S. Patent No. 3,505,140). The significance of the Dunn patent to this case will be discussed later.[4]

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[4] Because the Dunn patent is referred to a number of times in this opinion, it has been reproduced in Appendix B following a reproduction of the patent in suit.

It was in the early 1970's that Polaroid began to produce the types of laminate envelopes that are the two accused structures in this case: the Polaseal envelope, introduced about 1971, and the Polapress envelope. The latter was the subject of U.S. Patent No. 3,495,501 filed in 1973 by Paul A. Andrews and Richard M. Raia and assigned by them to Polaroid.

The starting point in consideration of any challenge to the validity of a patent is the language found in 35 U.S.C. § 282. That section, at the time of commencement of this suit, provided that "[a] patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it." Although the above presumption does exist it is clear from the case law that it is by no means conclusive and can be overcome by the party asserting the invalidity. See, e.g., Westinghouse Electric & Manufacturing Co. v. Formica Insulation Co., 266 U.S. 342 348 (1924). To go one step further, it has been settled in this circuit that "[t]he presumption, at least where a combination patent claim is involved, is not a heavy one to begin with." Futorian Manufacturing Corp. v. Dual Manufacturing & Engineering, Inc., 528 F.2d 941, 943 (1st Cir. 1976); Lawrence Rigging, Inc. v. Airtek Corp., 182 USPQ 375 (D. Mass. 1974). I believe that the patent alleged in this case to have been infringed is such a combination patent. Based on

the reasoning set forth in the pertinent cases, and from a review of the evidence in this case, I find that the presumption of validity of the '512 patent is dissipated.

Looking specifically to the patent in suit, it is apparent from the record that Avant contends that that patent was not anticipated in the prior art by virtue of the fact that it claims certain distinctive elements. Those elements essentially are as follows:

(1) congruent outer plastic sheets;

(2) maintenance of congruency, which is attained by accurately positioned heat seals (coupling means);

(3) ability of the outer sheets to be widely separate ("butterflying");

(4) accurate initial registration (alignment) of an insert by positioning it against the coupling means;

(5) snapping back of outer sheets after insertion to grip the insert and prevent slipping (maintain alignment) prior to lamination;

(6) heat activated face-to-face lamination; and

(7) elimination of post-lamination trimming.

I find that the '512 patent is invalid under 35 U.S.C. § 103 because the subject matter of that patent when taken as a whole was obvious at the time the invention was made to a person having ordinary skill in the art to which that subject matter pertains. As I will elaborate below, I feel that the subject of the '512 patent is but a combination of elements found in the prior art. Although a patent which brings together such elements may be valid, to be so it must represent a synergy, resulting from their union. Thus, as the established test for combination patents states, "[t]he conjunction or concert of known elements must contribute something; only when the whole in some way exceeds the sum of its parts is the accumulation of old devices patentable." Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., 340 U.S. 147, 152 (1950). See Forbro Design Corp. v. Raytheon Co., 390 F. Supp. 794, 801 (D. Mass. 1975), aff'd, 532 F.2d 758 (1st Cir. 1976). A review of the '512 patent, the prior art, and the evidence before this Court leads me to conclude that each of the elements claimed in the patent in suit was present in the prior art either independently or in combination and that their use in that patent have created nothing so new or unusual that it could be patentable. To avoid uncertainty as to how this conclusion is reached, each

of those elements should be dealt with individually.

It is plain from a reading of the '512 patent that it claims the use of congruent outer plastic sheets, those sheets being held together by the coupling means (heat seals or welds). The use of the phrase "congruent face-to-face relationship" in Claim 1 of the patent is taken by this Court to mean that the outer edges of the plastic sheets coincide. The patent does not, however, place any significance on congruency. From testimony presented at trial, it appears as if Avant's assertion is that congruence of the plastic sheets relates to the advantage of avoiding post-lamination trimming of die cutting. Such a relationship is nonetheless not expressed in the '512 patent. In addition, I would agree with Polaroid in its argument that avoidance of post-lamination die cutting is not the necessary and inevitable result of congruency. The significance of the congruent relationship is also left unclear when it is realized that the patent in suit does not specify tolerances relating to congruency that would be allowable in the practicing of the patent. It would seem that such tolerances would be necessary in production of the types of envelopes that are the subject of the patent in suit. In any event, the Court can find in the '512 patent no significance attached to congruency other than its possible relationship to elimination of post-lamination die

cutting, which will be dealt with in more detail later in the Court's findings. Furthermore, I do not find that congruency, in and of itself, is an element unique to the method taught in the '512 patent. An examination of envelopes or pouches used with the platen press, as well as other types of envelopes in the prior art which have been presented as exhibits in this case, reveals outer sheets held together in relationships that, taking reasonable tolerances into account, can be considered congruent.

The use of heat seals or welds as a coupling means for holding together plastic sheets prior to lamination is certainly nothing new in the prior art. Indeed, there is no question that this type of coupling means was employed in the fabrication of the early platen pouches. Avant, however, argues not only that the positioning of the coupling means in the prior art was not as precise as in the envelope which is the subject of the '512 patent, but also that a significant use of these welds as taught in the '512 patent was previously unanticipated. What Avant alludes to is the use of the seals as an abutment against which an insert can be placed so as to achieve accurate initial registration prior to lamination. A reading of the Dunn prior art patent, however, indicates that the above elements of the '512 patent were indeed already present in the prior

art.[5] Dunn teaches use of adhesive sheets that "may have a small portion which adheres to each other . . . to provide a hinge means or a means normally holding the two sheets . . . directly together." That patent goes on to specify that "the line of adhesion provides an edge . . . against which the card or sheet-like article to be laminated may be initially abutted, if desired, to facilitate initial registration thereof." It could be argued that the envelope in Dunn differs from that taught by the '512 patent in that the coupling means used in Dunn is an adhesive rather than heat seals or welds, and is a continuous edge rather than a number of tackings. Nevertheless, the important fact is that Dunn teaches the use of a hinge or coupling means along one of the four edges of an envelope against which an insert can be accurately aligned.[6]

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[5]The Dunn patent application was filed April 20, 1966, and is dated April 7, 1970. The '512 patent application was filed April 19, 1967, and is dated July 25, 1972.

[6]An examination of the diagrams found in the Dunn patent also appears to indicate a congruent relationship between the outer sheets, as well as the ability of those sheets to be widely separated to receive an insert.

Many of the elements which Avant asserts are unique to the '512 patent are in fact present in the types of envelopes, or half pouches, used with the platen presses prior to the filing of the patent in suit. Such a half pouch, as exemplified by exhibit P2N, is an envelope of essentially congruent plastic sheets which have been joined along one of four edges by heat seals. These outer sheets may, as in the case of the type of envelope taught by the '512 patent, be widely opened ("butterflied") so that an insert may be placed between them. Such an insert can be abutted against the seals for initial registration prior to lamination. That such a practice was done on occasion in the past is reflected by the record in this case. Avant points out that the operating instructions for a platen press placed in evidence at trial as exhibit P2 instruct the user to locate centrally any insert within the plastic sheets, thus implying that such an insert should be kept-away from the seals. However, although the seals in the platen pouches may not always have been as precisely produced as those found in the '512 patent envelopes are asserted to be, and may not have been originally intended as something against which to abut an insert, one cannot ignore the fact that the practice of using the seals as an abutment was not unknown or unpracticed. In addition, as inspection of platen pouches introduced as exhibits at trial will reveal, once an insert has been placed against the seals, the outer sheets close in a manner sufficient to

grip the insert. A final characteristic of the platen envelope is that, following lamination, it can be left untrimmed, depending upon its intended use. Granted, such pouches were in the past often trimmed or die cut. But the avoidance of this post-lamination process is something not unknown to users of the platen press. The record reveals not only that there were situations in which a post-lamination platen pouch would go untrimmed, but also that it was not an uncommon practice for pouches to be pre-cut in halves or quarters to facilitate the lamination of cards of varying dimensions.

Nowhere does the '512 patent either claim or refer to the elimination of post-lamination trimming or die cutting. Although Avant apparently is arguing that the elimination of such procedures is inherent in the '512 patent, I do not find that that is the result that necessarily would follow from practicing the patent's method. In any event, this Court does not feel that the avoidance of post-lamination cutting or trimming was unknown in the prior art. As has already been mentioned, envelopes used with the platen press were at times left untrimmed or die cut after lamination, depending upon intended use or the whim of the individual for whom the laminate was produced.

Regarding the avoidance of post-lamination trimming or cutting in the prior art, I would also refer once again to the Dunn patent. The drawings found

in that patent clearly depict an envelope of predetermined dimensions. A reading of Dunn reveals passages which certainly suggest the fabrication of an envelope which avoids post-lamination trimming or cutting. At one point Dunn states that "[p]eripheral positions of the finished lamination assembly may be trimmed by individual user," suggesting that the finished product need only be cut or trimmed to make it more suitable to the user's liking. More specifically, it can be argued that Dunn teaches pre-lamination cutting by the fact that it provides the following:

> The lamination unit of this invention may be made in several sizes so as to fit small card-like articles, large stationery-size articles, or several other sheet sizes. Therefore, unlike the case with laminating mechanisms, the size of the sheet which may be laminated is relatively unlimited, merely based upon the sizes in which the units are made.

Thus, as reflected in the above discussion, this Court is of the opinion that the elements asserted to be unique to the '512 patent can be found in the prior art, merely by examining the Dunn patent and the pouches used with the platen press. I cannot say after consideration of the entire record that those elements have been used in the '512 patent in a new or unusual manner. I find that because the subject matter of the '512 patent was obvious to those

skilled in the art when the patent was originally filed, the patent in suit herein is invalid under 35 U.S.C. § 103.

Polaroid also argues that the patent in suit is invalid under subsections (a), (b), (e), and (g) of section 102. Thus, that section reads in pertinent part:

> A person shall be entitled to a patent unless--
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> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use of on sale in this country, more than one year prior to the date of the application for patent in the United States, or
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> * * *
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or
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> * * *
>
> (g) before the applicant's invention thereof the invention was

made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

I cannot agree with Polaroid in its argument as to section 102. While the elements of the '512 patent were already present in the art, I do not feel they are all sufficiently embodied by any single prior patent or structure, including the Dunn patent and the platen pouches. The '512 patent cannot therefore be invalidated under section 102.

Finally, Polaroid argues that the '512 patent is invalid under 35 U.S.C. §112 in that it fails distinctly to claim and adequately to describe its subject matter. I find no merit in this assertion. The '512 patent sufficiently meets the requirements set forth in section 112.

In view of the foregoing opinion that the patent in suit is invalid under 35 U.S.C. § 103, judgment is to be entered for the defendant on the claim of infringement.

(Signed Frank H. Freedman)
United States District Judge

(APPENDIXES OMITTED)

APPENDIX B

United States Court of Appeals
For the First Circuit

No. 77-1349

AVANT INCORPORATED,
PLAINTIFF, APPELLANT,
v.
POLAROID CORPORATION,
DEFENDANT, APPELLEE.

APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS
[HON. FRANK H. FREEDMAN, *U.S. District Judge*]
[441 F. Supp. 898]

Before
CAMPBELL and BOWNES, *Circuit Judges*,
GORDON, *District Judge.**

George E. Kersey for appellant.
David L. Foster, with whom *Frederick L. McKnight*, *Wilkie, Farr & Gallagher*, and *Goodwin, Procter & Hoar* were on brief, for appellee.

March 21, 1978

CAMPBELL, *Circuit Judge*. Avant Incorporated sued Polaroid Corporation for infringement of patent No. 3,679,512 (the '512 patent) issued to Avant as assignee of the inventor. The patent disclosed an allegedly novel plastic envelope which, after the insertion of a data card, is to be subjected to heat and pressure in order to produce a laminated data card. The district court found for Polaroid on the latter's counterclaim which asserted that the patent was

* Of the Eastern District of Wisconsin, sitting by designation

invalid for obviousness under 35 U.S.C. § 103. *Avant Inc.* v. *Polaroid Corp.*, 441 F. Supp. 898 (D. Mass. 1977). Avant appeals.

The patented envelope is composed of two plastic sheets joined by elongated spot welds or heat seals. In the words of the application, these "welds or seals couple and maintain the outer sheets in a congruent relationship," and at the same time "act as nests to receive and properly orient the inner data card which may be inserted in a second or so."[1] The outer sheets of clear plastic thus form a sandwich which, upon insertion of the card to be laminated and application of correct amounts of heat and pressure, fuse so as to produce a laminated card.[2]

[1] Claim 1 of the patent is framed as "a method of producing a laminated data card having a plurality of edges," the steps in which comprise, first of all, providing an envelope having a coupling means for maintaining the outer sheets in a "congruent face-to-face relationship with each other." The coupling means is to be positioned so as to permit "wide separation" of the sheets, and to permit proper location of an edge of the insert abutting the coupling means. Claim 1 goes on to state that the claimed method separates the outer sheets along at least two outer edges to permit a data sheet "to be easily and rapidly inserted between said outer sheets and gripped thereby." The patented method is said further to comprise the steps of "inserting an inner data bearing sheet between said outer sheets and against said coupling means for accurately positioning an edge of said data-bearing sheet with respect to said outer sheets," and, finally, to laminate the outer sheets and inner data bearing sheet "by the application of heat thereto." Claim 2 is of the "method of claim 1 wherein said coupling means is formed by heat sealing said first and second outer sheets together at widely separated positions of said outer sheets to provide for accurate alignment of the edges of said inner data bearing sheet."

The emphasis throughout the patent is upon the ability of the described envelope to receive and maintain the data card in the correct position, without shifting. There is no hint that the invention teaches a lamination method eliminating post-molding ooze or wavy edges.

[2] Fusion is accomplished by the melting of the inner side of each plastic sheet. The outer portion is designed to withstand the heat. The patent does not describe the composition or chemistry of the two plastic sheets; lamination by heat utilizing these principles was well known prior to the patent.

It is important to note, as did the district court, that while the envelope must be used in conjunction with a machine capable of providing the requisite heat and pressure, and while successful lamination requires the plastic sheets to possess certain properties so as to fuse properly, the '512 patent does not claim or teach anything about molding machines, laminating materials, temperature variables, period of heat application, or pressure. The patent dwells upon the design of the envelope, emphasizing its ability to align and secure the data card and to avoid disturbing the moist surface of an inserted photograph.

Not surprising, the district court found the '512 patent invalid for obviousness under 35 U.S.C. § 103. While not precisely replicated in a single prior patent, and hence not in violation of 35 U.S.C. § 102, the patent was clearly foreshadowed by the prior art, in particular by so-called platen pouches and by the Dunn patent. Platen pouches have been widely used for lamination. They consist of two conjoined, roughly congruent plastic sheets that are designed to receive a data card and are thereafter laminated by heat. While the platen pouch and related molding process are less sophisticated than the patented envelope and its related process, both envelopes involve a very similar basic concept. The Dunn patent disclosed a plastic envelope and taught, as the district court found, "the use of a hinge or coupling means along one of the four edges of an envelope against which an insert can be accurately aligned." Dunn also indicated, in its diagram, a congruent relationship between the outer sheets, as well as the ability of those sheets to be widely separated to receive an insert. For these and for other reasons developed in the opinion below, we agree with the district court that a person skilled in the relevant art would have had little difficulty in arriving at an envelope of this nature.[3]

[3] Avant urges us to recognize that the greatest inventions may be simple. We so concede, but this gets us nowhere: many nonpatentable devices are simple also.

Perhaps because it recognizes that if the '512 patent is taken at face value—as in essence the description of an envelope for lamination containing certain useful but not remarkable features—a finding of obviousness is unavoidable, Avant argues that the patent actually discloses an entire "method" of laminated card manufacture. Hence the cryptic mention of a "congruent" relationship is said to reveal a means to prevent "ooze of the adhesive from between the sheets of plastic and thus avoids the irregular edge distortion that invariably occurred in the prior art. . . ." We are told that since laminating techniques prior to use of this envelope involved pouches with excess material on the edges that had to be trimmed after molding, this patent teaches, in essence, a new process of lamination whereby a card is inserted in an already shaped envelope which requires no cutting of trimming afterwards.

But we cannot see that it was some novel teaching in the '512 patent that made it possible to trim first and mold later. Avant's own version of the inventive history leads to the opposite conclusion. If earlier laminating techniques resulted in ooze and wavy edges, it obviously made no sense to trim and finish the pouch prior to molding so long as the molding process itself was bound to distort the edges. But once the molding art improved so as to eliminate such problems, utilization of a pre-cut envelope such as the patent describes became a perfectly obvious possibility. Improvements in the molding art did occur. The platen press was replaced with the chip bonder, and envelopes can now be heated and bonded without distortion. These key developments may or may not have involved patentable invention, but once they took place invention was not required to finish off the pouch earlier rather than later.

Avant argues that by requiring "congruency" the patent did, in effect, teach an advance in molding technique and

hence reached the level of invention. Congruency is said to have produced a "surprising" result, in that the molten plastic did not ooze but, for reasons not fully understood, stayed put. Thus, although the patent says not a word to connect congruency with an improvement in the molding art, we are asked to find the word "congruent" the key to the invention—which is thus transformed into an invention of a heat-molding technique, rather than of simply a convenient laminating envelope.

There are two answers to this condition. First, while congruency of the two sheets may be one of the conditions necessary to mold even edges, it was not established that anyone would ever have thought otherwise. Envelopes and folders are quite often congruent. Second, the teaching of congruency, without more, does not disclose the "invention" of how to mold so as to avoid disfigured edges. Other matters—the right combination of heat, materials and machine--are clearly of equal or greater significance to achieve that result; and about such matters the patent teaches nothing. There was, indeed, evidence that the patented envelope will ooze, and did ooze, unless the correct combinations of heat and molding materials are used. While an inventor need not understand all the principles and benefits of his invention, he must make "such disclosure and description of his invention that it may be put into practice." *Diamond Rubber Co.* v. *Consol. Tire Co.*, 220 U.S. 428, 436 (1910); *Rosen* v. *Lawson-Hamphill, Inc.*, 549 F.2d 205, 211 n.5 (1st Cir. 1976). Even if we assume the '512 patent refers to a technique for heat-molding rather than simply an efficient envelope with certain useful features for the reception and alignment of a card, it does not adequately disclose and describe the invention.[4] Not only does the

[4] The district court's finding that the patent distinctly claimed and adequately described its subject matter, as required under 35 U.S.C. § 112, was grounded on what the court understood its

patent fail to reveal all the necessary steps, it does not even spell out the degree of congruency—the tolerances—required to achieve the effect now claimed. The conclusion is inescapable that the patent is only what it appears to be —a design for a particular kind of envelope to be used in the lamination process, and as such, void for obviousness.

Avant also relies on the "sign-posts" of commercial success and acceptance as establishing invention. However, Avant has not shown that the envelope described in the '512 patent was the key to the success and acceptance which the chip bonding lamination technique employed by Avant, and now by others, has enjoyed. Central to such success has been a bonding machine and molding process making it possible to utilize an envelope of the type set forth in the '512 patent in an efficient manner. Avant cannot bootstrap this success to the use of the envelope made out in the patent, any more than it can claim the chip bonding technique is covered by the patent itself. In the '512 patent we can find nothing more than an efficiently designed but unremarkable envelope which was not shown to have been, by itself, the linchpin of Avant's commercial success.

Avant complains that the district court erroneously excluded certain responses by Polaroid to requests for admission, but the record indicates that exclusion was due to Avant's procedural default and consequent waiver of its rights to have the admissions admitted into evidence.

We have carefully considered Avant's other arguments in its brief and reply brief, and find them to be without merit.

Affirmed.

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subject matter to be—essentially, the design of an efficient envelope, not a technique for heat molding resulting in undistorted edges and corners.

Adm. Office, U. S. Courts — Blanchard Press, Inc., Boston, Mass.

APPENDIX C

EXCERPTS FROM THE CONSTITUTION OF THE UNITED STATES OF AMERICA

ARTICLE I—Section 8—1. The Congress shall have power:

8. To promote the progress of science and useful arts by securing for limited times to authors and inventors the exclusive rights to their respective writings and discoveries.

AMENDMENT V—No person shall be held to answer for a capital or other infamous crime unless on a presentment or indictment of a grand jury, except in cases arising in the land or naval forces, or in the militia, when in actual service, in time of war or public danger; nor shall any person be subject for the same offence to be twice put in jeopardy of life or limb; nor shall be compelled in any criminal case to be a witness against himself, nor be deprived of life, liberty, or property, without due process of law; nor shall private property be taken for public use without just compensation.

APPENDIX D

EXCERPTS FROM TITLE 35, UNITED STATES CODE

§ 100. Definitions

When used in this title unless the context otherwise indicates—

(a) The term "invention" means invention or discovery.

(b) The term "process" means process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.

(c) The terms "United States" and "this country" means the United States of America, its territories and possessions.

(d) The word "patentee" includes not only the patentee to whom the patent was issued but also the successors in title to the patentee.

§ 101. Inventions patentable

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

§ 102. Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other. (Amended July 28, 1972, Public Law 92–358, sec. 2, 86 Stat. 501.)

Note 1.—Section 3(b) of Public Law 92–358 provides that: "Section 2 of this Act [amends subsection (d) of this section] shall take effect six months from the date when Articles 1–12 of the Paris Convention of March 20, 1883, for the Protection of Industrial Property, as revised at Stockholm, July 14, 1967, come into force with respect to the United States and shall apply to applications thereafter filed in the United States." The cited articles entered into force for the United States on August 25, 1973. (See "United States Treaties and Other International Agreements" TIAS 7727.)

Note 2.—For amendment to paragraph (e) of this section relating to the Patent Cooperation Treaty (not yet in force) see text of Public Law 94–131, p. 108 *et seq.* of this pamphlet.

§ 103. Conditions for patentability; non-obvious subject matter

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

§ 112. Specification

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. A claim may be written in independent or dependent form, and if in dependent form, it shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim.

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. (Amended July 24, 1965, Public Law 89–83, sec. 9, 79 Stat. 261.)

Note.—For amendment of this section relating to the Patent Cooperation Treaty (not yet in force) see text of Public Law 94–131, p. 108 *et seq.* of this pamphlet.

APPENDIX E

FEDERAL RULES OF CIVIL PROCEDURE for the United States District Courts

Rule 1. Scope of Rules. These rules govern the procedure in the United States district courts in all suits of a civil nature whether cognizable as cases of law or in equity or in admiralty, with the exceptions stated in Rule 81. They shall be construed to secure the just, speedy, and inexpensive determination of every action.

Rule 61. Harmless Error. No error in either admission or the exclusion of evidence and no error or defect in any ruling or order or in anything done or omitted by the court or by any of the parties is ground for granting a new trial or for setting aside a verdict or for vacating, modifying, or otherwise disturbing a judgment or order, unless refusal to take such action appears to the court inconsistent with substantial justice. The court at every stage of the proceeding must disregard any error or defect in the proceeding which does not affect the substantial rights of the parties.

CERTIFICATE OF SERVICE

I, George E. Kersey, Attorney for Petitioner, certify that three copies of the above Petition for a Writ of Certiorari were served on the Respondent by mailing same first-class, postage prepaid, to Willkie Farr & Gallagher, Attorneys for Respondent, 1 Citicorp Center, 153 East 53 Street, New York, New York 10022.

George E. Kersey

COPY 19

Supreme Court, U. S.
FILED
JUL 19 1978
MICHAEL RODAK, JR., CLERK

IN THE

Supreme Court of the United States

October Term 1977

No. 77-1837

AVANT INCORPORATED,

Petitioner,

v.

POLAROID CORPORATION,

Respondent.

BRIEF OF POLAROID CORPORATION IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

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BRIEF OF POLAROID CORPORATION IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

There is nothing about this ordinary patent case which warrants a review by this Court on the merits.

The decision of the Court of Appeals for the First Circuit, holding petitioner's patent invalid, is manifestly correct. There is no conflict between decisions of Courts of Appeals on the same matter. No question of public importance is involved. There has been no departure from the accepted and usual course of judicial proceedings. In short, there is no special or important reason why the writ prayed for should be granted.

QUESTIONS PRESENTED

The fundamental question is whether a District Court may properly hold invalid for obviousness, under 35 U.S.C. Sec. 103, a patented method for laminating a data card which comprises (i) providing an envelope, all features of which were known and used in the prior art, and (ii) taking advantage of these features, in a natural and unsurprising way and in a manner plainly taught by the prior art.

Petitioner Avant Incorporated ("Avant") raises eleven subsidiary questions which can be succinctly encapsulated in two questions:

(1) Whether the findings of fact, which predicate the unanimous decisions of the United States Court of Appeals for the First Circuit and the decision of the District Court of Massachusetts invalidating the patent in issue, should be reexamined by this Court when those findings are amply supported by evidence, were found pursuant to, and are embodied in decisions which accord with, decisions of this Court, decisions of other courts of appeals, and are not urged by Avant, by citation of any authority, to be in any way at odds with settled law; and,

(2) Whether the District Court, in allowing Avant to offer into evidence whatever timely-presented proof it wished, departed from the accepted and usual course of judicial proceedings and violated the requirements of due process by (i) rejecting certain evidence after Avant waived its right to introduce such evidence, (ii) relying on the correctness of Hazeltine Research, Inc. v. Brenner, 382 U.S. 252 (1965), or (iii) in issues raised for the first time in this Court, limiting trial of the validity of a simple patent to two days, rendering its decision a year after trial, or indicating during trial that the evidence earlier presented pointed to the invalidity of the patent in issue.

STATEMENT OF THE CASE

Avant is the assignee of United States Patent 3,679,512 (the "'512 patent"), allegedly conceived and reduced to practice in June 1966. The patent was issued on July 25, 1972, and Avant filed

its infringement action on December 27, 1972. Polaroid answered and counterclaimed for a declaratory judgment of invalidity of the '512 patent. Polaroid's invalidity defenses and counterclaim were based upon: (1) 35 U.S.C. Sec. 102 because of anticipation, prior public use, prior knowledge, and prior public sale; (2) 35 U.S.C. Sec. 103 because of the obviousness of the subject matter of the '512 patent to a skilled mechanic presumed to know the prior art; and (3) 35 U.S.C. Sec. 112 for failing distinctly to claim and adequately to describe the subject matter of the '512 patent.

On December 17, 1974, Polaroid filed a motion for summary judgment on its counterclaim of invalidity and the parties submitted extensive briefs, affidavits and numerous exhibits. The motion for summary judgment was denied without prejudice by the District Court, discovery was concluded and, with the concurrence of Avant, a trial on the issue of validity was scheduled and held on June 7 and 8, 1976.

Following the trial, at Avant's own suggestion, (Trial Transcript, Second Day, p. 100) the parties designated for the record hundreds of pages of deposition testimony, and submitted over a hundred pages of post-trial memoranda, proposed findings of fact and suggested conclusions of law.

The District Court rendered its opinion on June 8, 1977, holding the '512 patent invalid for obviousness under 35 U.S.C. Sec. 103. Avant Incorporated v. Polaroid Corporation, 441 F. Supp. 898

(D. Mass. 1977) (28a-48a).* Avant appealed to the United States Court of Appeals for the First Circuit some, but by no means all, of the issues presented by Avant in its Petition for Certiorari (several of which questions were not even raised in the District Court). After receiving the parties' briefs and hearing extended oral argument, on March 21, 1978, the First Circuit affirmed the opinion of the District Court in all respects. Avant Incorporated v. Polaroid Corporation, 572 F.2d 889 (1st Cir. 1978) (49a-54a).

The '512 patent** claims a method for laminating a data card insert (e.g., a driver's license) between a pair of outer transparent sheets. The art of laminating inserts between plastic sheets by heat or pressure is old. As taught in the prior art, it is conventional to place the insert between two plastic sheets which have an adhesive on their inner surfaces. When heat is to be employed to seal the envelope, the adhesive may consist of inner layers of plastic more heat responsive than the outer layers, so that when heat is applied by a device referred to generically as a "laminator," "bonder" or

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* Parallel cites to the decisions of the courts below refer to the appendix section of Avant's Petition and are designated by the appendix page number and the small letter "a".

** The '512 patent is annexed as an appendix to respondent's brief and is designated by the appendix page number and the small letter "r".

"press," the adhesive softens and binds together the heat resistant outer layers.

The '512 patent, entitled "Laminated Card Envelope," is admittedly simple. Although the laminating art has been much refined by development of new bonders and associated devices, research on different types and amounts of plastic and experimentation with the crucial operating variables of degree of heat and pressure, the '512 patent does not teach or claim any of those refinements. Rather, it simply claims a monopoly on a method of laminating an insert by starting with an envelope of two neatly aligned, equal size sheets (referred to, by implication in the '512 patent, 31r, as "congruent" sheets). The sheets are interconnected along one edge so that the opposing surfaces may be opened wide like a book ('512 patent, 31r). At its simplest, the envelope may be a single sheet of double layered plastic folded in half and reopened ('512 patent, 31r). A data card insert is inserted between the opposing sheets as a page of longhand notes might be inserted into a law book ('512 patent, 31r). The card is then pressed against the fold or interconnection (referred to as "coupling means"*) to facilitate registration

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* The "coupling means" of the envelope can have a number of configurations. As set forth in the "Specific Description" of the patent, such coupling means can

(footnote continued)

of the insert in a neat way ('512 patent, 31r). The sheets are then closed upon the insert, and heat is applied ('512 patent, 31r).

The evidence, findings and decisions below established that all elements of the method claimed in the '512 patent are present in the prior art. In a desperate effort to find something unobvious, Avant has increasingly relied upon the fact that the '512 patent claims "congruent" outer sheets, and that modern commercial systems which have attained a measure of success use neat, pre-sized envelopes. Avant then attempts to tie the modern commercial structure to the patented method by arguing (without evidentiary support) that since modern envelopes often do not "ooze" objectionable amounts of adhesive beyond their superimposed edges, the absence of "ooze" is attributable to "congruency," rather than to refinements in types and amounts of adhesive, the degree of heat and amount of pressure. Not only is there no evidence whatever in the record to support that contention, but it

(footnote cont'd from preceeding page)

simply be the fold of a sheet of material which has been folded in half. Alternatively, the coupling means include "nests" orthogonally positioned to each other as depicted in the patent drawing or a bar weld along one side of the envelope. Indeed, the coupling means could consist of adhesives such as pressure sensitive adhesives rather than simply a heat seal.

is dramatically refuted by the fact that Avant itself prosecuted a later-filed patent specifically directed toward minimization of "ooze" in which the crucial factor is proclaimed to be the amount of adhesive, United States Patent 3,679,514 (the "'514 patent").

The District Court, after trial in open court and after receiving extensive designations of deposition testimony and numerous exhibits and after petitioner Avant rested its case (without accepting the District Court's invitation to submit further evidence, Trial Transcript, Second Day, p. 182), adjudged the '512 patent invalid as obvious under 35 U.S.C. Sec 103. The District Court specifically found that all elements of the '512 patent were present in the prior art, 441 F. Supp. at 903, 906 (40a, 47a), that those asserted elements were not used in the subject matter of the '512 patent in any new or unusual way, ibid, and that "congruency" of the envelope was not a feature unique to the '512 patent but was present in the prior art, id. at 904 (41a-42a, 43a).

The United States Court of Appeals for the First Circuit affirmed, finding, as had the District Court, that the '512 patent was not precisely replicated in a single prior art patent but was clearly foreshadowed by the prior art, 572 F.2d at 890 (51a), that the patent contained no remarkable features and that a finding of obviousness was unavoidable, id. at 890 (52a). The Court of Appeals' opinion principally focused upon the assertions by Avant, argued at length at the appellate level, that the '512 patent

should be interpreted in a fashion strikingly different from the language of the claims. Id. at 891 (52a, 53a). As noted above, Avant pitched its argument upon the assertedly inevitable, but inexplicable, ramifications of "congruency" and ascribed to the '512 patent the advantage of eliminating the necessity for further trimming (as by "die-cutting") after lamination, notwithstanding Avant itself in prosecuting the '514 patent had stated that that advantage was first achieved by that later filed patent.

Respecting "congruency," the Court of Appeals noted the not surprising proposition that by starting with even edges one might be more likely to end up, after applying heat, with even edges. Id. at 891 (52a). Indeed, the court noted that no one would ever suggest any different proposition. Id. at 891 (53a). The Court of Appeals found, as did the District Court, that the congruent envelope of the '512 patent did in fact "ooze," absent the application of techniques not disclosed or claimed in the patent. Moreover, if the monopoly claimed in the '512 patent were deemed to be a heat-laminating technique which avoided post-lamination trimming by the simple expedient of beginning with neatly aligned edges, irrespective of heat, pressure or quantity of adhesive, the '512 patent, because of its failure to disclose such an invention or the important factors necessary to achieve that asserted result, id. at 891-92 (53a-54a), was additionally invalid under 35 U.S.C. Sec. 112, ibid.

The Court of Appeals also held that, pursuing the analysis suggested by

this Court in Graham v. John Deere Co., 383 U.S. 1, 17 (1966), there was insufficient evidence of secondary indicia of nonobviousness to challenge the findings that the subject matter of the '512 patent, taken as a whole, was obvious to mechanics skilled in the art at the time of the "invention." Id. at 891 (54a).

In addition, the Court of Appeals specifically rejected Avant's assertion that evidence was improperly excluded and rejected generally Avant's challenges to the District Court's holdings. Id. at 892 (54a).*

REASONS FOR DENYING THE WRIT

The decisions of the courts below, in holding that the '512 patent is invalid for obviousness, are amply supported by evidence, are in full accord with the standards of patentability specified by Congress, this Court and the United States Constitution, and were rendered after careful consideration of the abundant evidence of obviousness presented in a procedurally fair manner.

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* Avant never raised before either court below many of the procedural challenges first made here -- that the two-day trial was too short, that the District Court took too long in rendering its opinion or that the District Court did not at all times give the appearance of impartiality.

None of the so-called questions presented by Avant is appropriate for review on Certiorari. Three of those questions (Nos. 1, 9 and 11) raise procedural matters -- primarily not raised in either court below -- whose prosaic character cannot be concealed by Avants reference to them as deprivations of due process. One of Avant's questions (No. 10) seeks to call in question -- apparently on constitutional grounds, although no serious constitutional argument was urged below -- a legal determination of both lower courts which was in specific accord with a dispositive ruling by this Court, repeatedly followed by the courts of appeals, without the citation of a single authority to support Avant's position. The balance of Avant's purported questions, when stripped of distortions and placed in context, constitute nothing more than a request to this Court to re-try the issues of patent invalidity and to upset the findings of fact and conclusions of obviousness which underlie the decisions of the District Court and the unanimous Court of Appeals panel.

ARGUMENT

POINT I

THE DECISIONS OF THE COURTS BELOW ARE AMPLY SUPPORTED BY EVIDENCE AND ARE IN ACCORD WITH SETTLED LAW.

The decisions below are amply supported by the evidence at trial, are in accord with settled law, and do not conflict with decisions in other courts of appeals. Despite all of the "Questions" raised by

petitioner Avant, Avant cites no case conflicting with any fair reading of the decisions below.

This Court has clearly delineated the tests for patentability under 35 U.S.C. Sec. 103 and the analytical inquiries appropriate for making that determination.

The basic obviousness test is set forth in 35 U.S.C. Sec. 103:

> A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains...

Resolution of the obviousness issue entails several basic factual inquiries enunciated in Graham v. John Deere Co., 383 U.S. 1, 17 (1966): "Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved."

The District Court in the instant action carefully and meticulously made each of these inquiries: it analyzed the prior art, compared the prior art with the '512 patent, determined the skill in the art and found the '512 patent wanting. 441 F. Supp. at 901-05 (33a-46a).

Two items of prior art, in particular, were found to be pertinent in appraising the '512 patent in suit -- precut "platen half pouches" which were commercially available long before the purported '512 patent "invention," and United States Patent 3,505,180 (the "Dunn patent"). The precut platen half pouches were described by the District Court as an envelope of:

> essentially congruent plastic sheets which have been joined along one of four edges by heat seals. These outer sheets may, as in the case of the type of envelope taught by the '512 patent, be widely opened ('butterflied') so that an insert may be placed between them. Such an insert can be abutted against the seals for initial registration prior to lamination.

Id. at 904 (43a). The coupling means or welds of the prior art platen pouches so maintain the outer sheets that the insert card, upon abutment to the welds, is gripped between the outer sheets.

There was a substantial amount of testimony by those who actually used precut platen half pouches. The envelopes were often used in precisely the same manner as that claimed by the '512 patent. An insert card was inserted into the envelope or precut pouch (formed by joining two rectangular sheets by heat welds along one side), abutted against the coupling means or welds, gripped between the opposite sheets, and heat laminated. Subsequent to lamination, the envelope was often, but not always, trimmed or die-cut.

The second significant item of the prior art is the Dunn patent, the application for which was filed on April 20, 1966, prior to the alleged date of "invention" of the '512 patent. Dunn discloses an envelope (termed a "laminating unit") for use in laminating inserts and specifically describes the alignment or registration function provided by a coupling means. Also, like the '512 patent, the Dunn envelope was hinged along one of four edges, to provide a butterfly.

Moreover, Dunn teaches precutting, depicting a precut envelope of congruent sheets in the drawing and stating that the "laminating unit" may be made in an unlimited number of sizes or made in basic sizes to fit inserts of particular sizes.

The Dunn patent claims a pressure-sensitive adhesive method of lamination and refers to the well-known prior art use of machine lamination involving heat.

Avant, in an attempt to distinguish its '512 patent from the precut platen pouches and the Dunn patent argued the supposed arcane relationship of oozing of adhesive and congruency of the '512 patent envelope as a basis for finding invention in the '512 patent. Thus, Avant contended in the Court of Appeals that a congruent envelope embodied significant inventive creation which achieved necessarily remarkable results of lamination,

and Avant then attempted to read these unsupported and undisclosed advantages into the '512 patent. Similarly, Avant in its Petition before this Court raises numerous questions which focus upon congruency and oozing and attacks the findings of fact below because the District Court and the Court of Appeals could not find evidence which supported Avant's contentions.

Avant's attack on the treatment of congruency is raised in its Question 2 as a straw man for the proposition that the Court of Appeals opinion requires a patent to specify engineering detail. That straw man is created because the Court of Appeals could not find that congruency was the key to the asserted invention, that congruency eliminated oozing or that congruency transformed the patent to one which claims a technique for eliminating ooze. Avant asserted, as here (Petition p. 18), that the '512 patent achieved: "Trimming first, and then heat lamination afterwards." The Court of Appeals, like the District Court, id. at 905 (45a), found as a matter of fact that the patent did not achieve that result and that the patent failed to disclose those other factors which were necessary to achieve that result. 572 F.2d at 891 (53a).

In its Question 3, Avant asserts that the Court of Appeals mandates that a patentee meet the "intolerable burden" of proving "the subjective states of mind of persons skilled in the art" (Petition p. 16). This assertion is prompted because the Court of Appeals, in examining whether the word "congruent" transforms the entire

nature of the patent, noted the obvious proposition that if one wants even edges, one might logically start with even edges, id. at 891 (52a, 53a), an unimpeachable proposition established in the record, practiced in the past, and fully in accord with common experience and straightforward logic.

In Question 5 Avant again attacks, in terms of "synergy," the Court of Appeal's failure to find the "surprising result" of "congruency," challenging the concurrent findings of fact below that there was no evidence that congruency eliminated excessive "ooze." 441 F. Supp. at 905 (45a), 572 F.2d at 891 (53a).

In Question 7 Avant again invokes congruency, asserting that the '512 patent was commercially successful because the congruent envelope eliminated post-lamination trimming, an assertion without factual support. In this connection, Avant also attacks the fact finding of the courts below concerning improvements in the laminating art and their relationship to congruency. Yet at trial, there was substantial evidence of numerous such improvements which minimized oozing and had nothing to do with congruency, particularly improvements with respect to the type of plastic materials and amount of adhesive. Avant's own '514 patent evidenced such a refinement and claimed, as a means of eliminating ooze, sparse amounts of adhesive. None of those factors or improvements was claimed or taught by the '512 patent in issue.

The congruency controversy evidences the creative energies expended, not in the invention of a patentable process, but in endeavoring to save an invalid patent by redefining its claims and creating an aura of mystery and complexity concerning its scope. Avant asserts that the '512 patent claims a technique for eliminating post-lamination die-cutting achieved because congruent edges eliminate ooze of adhesive. In mundane terms, Avant is asserting that melting cheese will not flow out from between two pieces of bread if the edges of the bread are aligned.*

Avant's attacks on the findings below raise no questions which merit review by this Court. Those findings should not be set aside unless they are clearly erroneous, Fed. R. Civ. P. 52(a), particularly where, as here, the District Court and Court of Appeals concurred in those findings. This Court's function in reviewing concurrent findings was epitomized in Graver Tank & Mfg. Co. v. Linde Air Products Co., 336 U.S. 271, 275 (1949) ("Graver I"): "A court of law, such as this Court is, rather than a court for correction of errors in fact finding, cannot undertake to review concurrent findings of fact by two courts below in the absence of a very obvious and exceptional showing of error." [Citations omitted]. See also Alabama Power Co. v.

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* Making a grilled cheese sandwich with a spatula and a stove is one of many types of heat lamination -- bonding material under heat and pressure.

Ickes, 302 U.S. 464, 477 (1938); United States v. O'Donnell, 303 U.S. 501, 508 (1938). Concurrent findings of fact are particularly entitled to respect in a patent action, Graver Tank & Mfg. Co. v. Linde Air Products Co., 339 U.S. 605, 610 (1950) ("Graver II"), and no less so in instances where the courts have invalidated the patent. Graver I, 336 U.S. at 279. In instances involving, as here, expert testimony, evaluation of prior art and demonstrations of the asserted capabilities of the patent, this Court has stated: "It is not for this Court to even essay an independent evaluation of this evidence. This is the function of the trial court." Graver II, 339 U.S. at 611. See also Williams Manufacturing Co. v. United Shoe Machinery Corp., 316 U.S. 364, 367 (1942) (findings of fact concerning whether a patent is a combination of old elements not to be disturbed where supporting evidence exists).

The District Court and Court of Appeals properly rejected Avant's assertions. In doing so, the courts below were supported by the evidence. Furthermore, they indulged Avant's theories and analyzed them with care. The courts below considered congruency from every possible perspective and found no view of congruency and oozing which could justify a monopoly of the laminating process embodied in the '512 patent or urged by Avant in its redefinition of its patent. First, both courts below found that congruent envelopes were known and used in the prior art. 572 F.2d at 890 (51a), 441 F. Supp. at 904 (41a-42a). Second,

both courts below held, consistent with Graver I, 336 U.S. at 277, that the '512 patent's scope was determined by its claims. 572 F.2d at 891 (54a), 441 F. Supp. at 900 (30a). The courts found that a fair reading of the claims and analysis of the evidence did not support reading the '512 patent as a patent for eliminating oozing, or a teaching to cut first and laminate second. 572 F.2d at 890-91 (52a, 54a), 441 F. Supp. at 905 (45a). Third, the Court of Appeals noted that if the patent were viewed as a process for eliminating oozing, it would necessarily be invalidated for failing distinctly to claim or adequately to describe its subject matter, pointing out that the patent did not reveal the steps of such a process nor refer to the numerous factors essential in eliminating ooze. 572 F.2d at 891 (53a-54a); cf. Graver I, 336 U.S. at 277-78 (process claims invalid for failing specifically to refer to essential constituents of composition used in the process). Fourth, the District Court noted that if the patent were indeed a technique for eliminating post-lamination die-cutting, that technique was known and used in the prior art, 441 F. Supp. at 905 (45a), a finding of fact fully supported by the evidence and not clearly erroneous. Fifth, the courts below observed that the notion that evenly aligned edges before heating facilitate evenly aligned edges after heating is obvious, and the Court of Appeals noted that no one would have thought otherwise, 572 F.2d at 891 (53a).

Beyond attacking the foregoing findings respecting the patent, Avant also urges, equally without merit, that the courts below did not analyze the '512 patent as a process patent (Question 4), that secondary indicia of non-obviousness were ignored by the courts (Question 6), and that the courts were so intellectually handicapped that they failed to grasp the issues of the case (Question 8).

The evidence and a fair reading of the decisions below are to the contrary. The courts below recognized that the '512 patent described and claimed a process or method and discussed the patent in those terms. 441 F. Supp. at 899 (29a); id. at 900 (30a); id. at 903-04 (41a); id. at 905 (45a); 572 F.2d at 890 (50a); id. at 891 (54a). However, they also recognized that the '512 process comprised providing an envelope and using that envelope in the normal manner suggested by its features.

A combination of old elements, whether embodied in a machine or a process, may not be patented if the combination does not produce a synergistic result. Sakraida v. Ag Pro, Inc., 425 U.S. 273, 282 (1976); Reckendorfer v. Faber, 92 U.S. 347, 356-57 (1875); Proler Steel Corp. v. Luria Brothers & Co., 417 F.2d 272, 277 (9th Cir. 1969); Accord, Anderson's-Black Rock, Inc. v. Pavement Salvage Co., 396 U.S. 57, 60-61 (1969); Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., 340 U.S. 147, 152-53 (1950).

The courts below applied these tests, found that the aggregation of old elements achieved by the '512 patent was neither surprising nor synergistic and concluded that the '512 patent was obvious.

Avant's tenuous assertions of secondary indicia of non-obviousness (Question 6) are equally unavailing, especially when obviousness is so clearly established. There was insufficient evidence in the record of any sign-posts of non-obviousness. The courts below found no such signposts except to the extent they found the '512 patent "simple," a characteristic hardly probative of invention, and found that the envelope of the '512 patent was used as a part of a system which enjoyed commercial success, although there was no evidence to support a finding that that success was attributable to the patent, 572 F.2d at 892 (54a).

In any event, it is clear that the courts below followed the standards of this Court in assessing such argued signposts or secondary considerations of invention. "[C]ommercial success without invention will not make patentability." Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., 340 U.S. 147, 153 (1950). That secondary considerations cannot salvage the obvious subject matter of a patent is manifest. In Graham v. John Deere Co., 383 U.S. at 17, this Court set forth the primary conditions that must be satisfied in any evaluation of obviousness and noted that such considerations as commercial success and failure of others are "secondary" considerations. The court made it clear, however, that those secondary considerations are no more than aids in the determination of obviousness, and that they do not supplant the primary tests or alter the statutory requirements.

There is no question that the courts below understood the patent and followed the directions of this Court in finding the '512 patent obvious. That the Court of Appeals used the terms "molding" and "laminating" interchangeably as a semantic convenience is not even suggested to affect analytically consideration of the '512 patent. Neither did the courts below misdirect their view of the prior art by looking at a prior art patent which used pressure rather than heat lamination. The pertinent features of the Dunn patent related to the structure of its congruent envelope and the courts found that it did not anticipate the '512 patent, but underscored the obviousness of the '512 patent.

POINT II

THE PROCEDURES FOLLOWED BY THE DISTRICT COURT CONFORM IN ALL RESPECTS WITH DUE PROCESS AND WITH BINDING PRECEDENT, AND PRESENT NO SUBSTANTIAL GROUNDS FOR THE GRANTING OF A WRIT OF CERTIORARI.

Avant raises a number of supposed procedural failings of the District Court as grounds for the issuance of a Writ of Certiorari. Upon examination, those supposed failings prove to be of the most trivial variety. Indeed, the trivial nature of most of the asserted procedural errors was conceded by Avant when it failed either to make objection in the District Court or to raise those

issues in the Court of Appeals. In any event, it is clear that the District Court's actions and rulings were wholly proper and fully in accord with binding precedent. Certainly, none of the procedural issues raised by Avant remotely approaches the standard for granting a Writ of Certiorari.

The procedural matters raised by Avant in its Petition include the following: (i) a delay of one year between trial and the rendering of a decision; (ii) the absence of certain portions of the record from the District Court files on certain dates; (iii) the utterance of a supposedly prejudicial remark; (iv) the shortness of the trial, supposedly depriving Avant of the ability to introduce certain evidence; (v) the reliance by the courts below on a prior art patent whose issuance was pending at the time the patent in suit issued; and (vi) the failure of the courts below to consider certain Rule 36 materials never offered in evidence by Avant.

Of those six procedural issues, numbers (i), (iii) and (iv) are raised for the first time in this Court. At no point below, either in the District Court or the Court of Appeals, did Avant assert as grounds for reversal that it was prejudiced by the delay between trial and decision, or object to the delay. With regard to the supposedly prejudical comment of the District Court, Avant's counsel failed to object to it in any way at trial, and failed to raise it as an issue before the Court of Appeals. Avant similarly utterly failed, until service of

the instant Petition, to object to the length of the trial, or to set forth any evidence which it might have been precluded from submitting by time pressure.

That a party has failed, despite many opportunities, to raise an issue below is grounds alone for this Court's refusing to consider it. As this Court recently stated in Regents of the University of California v. Bakke, 46 U.S.L.W. 4896, 4900 (June 28, 1978): "[T]his Court has been hesitant to review questions not addressed below." Accord, McGoldrick v. Compagnie Generale Transatlantique, 309 U.S. 430, 434-35 (1940); Blair v. Oesterlein Machine Co., 275 U.S. 220, 225 (1927) ("It is only in exceptional cases ... that questions not pressed or passed upon below are considered here.")

More important, Avant's failure to raise those issues previously, combined with the other relevant circumstances surrounding them, clearly shows their total lack of significance, even to Avant itself. Thus, although Avant now claims it was prejudiced because the trial lasted "only" two days, Avant rested its case, subject to the introduction of certain documentary exhibits, at the end of the first day. At the end of the second day the District Court once again asked Avant's counsel, George Kersey, if he had any further evidence to present, and he responded that he did not:

> THE COURT: ... Does the plaintiff have any further rebuttal?
>
> MR. KERSEY: No, Your Honor.

THE COURT: Both parties then rest?

. . .

MR. KERSEY: Yes, Your Honor.

(Trial Transcript, Second Day, p. 182.) Although Avant now claims that but for the supposedly shortened length of the trial it would have called Mr. Dunn as a witness (Petition at 24), Avant gave no indication at trial of any intention to call Mr. Dunn. Furthermore, on April 23, 1976, Avant submitted its "Memorandum Pursuant to March 29, 1976 Order" wherein it designated those witnesses whom it intended to call at trial. Mr. Dunn was not listed. The issue at this point is a pure afterthought, and certainly does not present the exceptional circumstances required to warrant this Court's consideration.

Examination of the remaining procedural issues similarly reveals both that the District Court's acts and rulings were wholly correct and that the issues raised are devoid of significance. Avant asserts that certain portions of the record were absent from the court files on certain dates, but shows no way in which it might have been harmed thereby. No assertion can be made that the District Court did not in fact review those portions of the record, and in any event the District Court attended the trial and took extensive notes of the proceedings. Furthermore, the questioned portions of the record were before the Court of Appeals, which affirmed the District Court's holding of invalidity. Although

Avant claims that the few "missing" items were the portions of the record "most favorable" to it (Petition at 10), in fact Avant designated only 18 transcript pages from those portions for inclusion in the Appendix on appeal to the Court of Appeals (Designation of Parts of the Record Which Appellant Intends to Include in the Appendix to Brief, dated August 15, 1977), while Polaroid designated 23 such transcript pages (Appellee's Designation of the Parts of the Record Which It Deems Should be Included in the Appendix, dated August 29, 1977).

The holdings of the courts below that the Dunn patent was part of the relevant prior art, even though the Dunn patent application was not public information at the time of issuance of the patent in suit, was correct. This Court dealt with the precise question in Hazeltine Research, Inc. v. Brenner, 382 U.S. 252 (1965), where it held that a co-pending patent application must be considered a part of the prior art even though its disclosures were secret and not known to the public. That decision has been uniformly followed by the federal courts, e.g., Shanklin Corp. v. Springfield Photo Mount Co., 521 F.2d 609, 617 (1st Cir. 1975), cert. denied, 424 U.S. 914 (1976); Triax Co. v. Hartman Metal Fabricators, Inc., 479 F.2d 951, 954 (2d Cir.), cert. denied, 414 U.S. 1113 (1973); In re Bass, 474 F.2d 1276, 1285 (C.C.P.A. 1973); Armour & Co. v. Swift & Co., 466 F.2d 767 (7th

Cir. 1972), and is soundly based in policy. As this Court stated in Hazeltine, supra:

> To adopt the result contended for by petitioners would create an area where patents are awarded for unpatentable advances in the art. We see no reason to read into §103 a restricted definition of 'prior art' which would lower standards of patentability to such an extent that there might exist two patents where the Congress has plainly directed that there should only be one.

382 U.S. at 256. Such a situation would hardly be consistent with the promotion of science and the useful arts mandated by the Constitution. In short, the Hazeltine rule is a clear and well-settled principle of patent law. The following of that principle by the courts below cannot warrant issuance of a Writ of Certiorari. See Rule 19(1)(b), Rules of the Supreme Court of the United States.

The exclusion by the courts below of certain Rule 36 materials once again was both a correct ruling and wholly devoid of significance worthy of the attention of this Court. Indeed, Avant concedes that the ruling was at worst "harmless error." (Petition at 27.) Avant also concedes that it rested its case without offering the Rule 36 admissions or reserving a right to designate them; nor did Avant move for a new trial upon learning of the preclusion. This Court should also be informed that many of the Rule 36 materials in question were served on Polaroid on the eve of trial,

so that responses were not due under the Rule until after the date of trial, and Polaroid never responded to those requests. As the District Court commented in its decision: "Polaroid raises serious questions as to whether ... all the requests for admissions could be deemed admitted under the given circumstances." 441 F. Supp. at 900 n.2 (32a).

CONCLUSION

For all the reasons stated above, Polaroid respectfully requests that the Petition for a Writ of Certiorari be denied in all respects.

Respectfully submitted,

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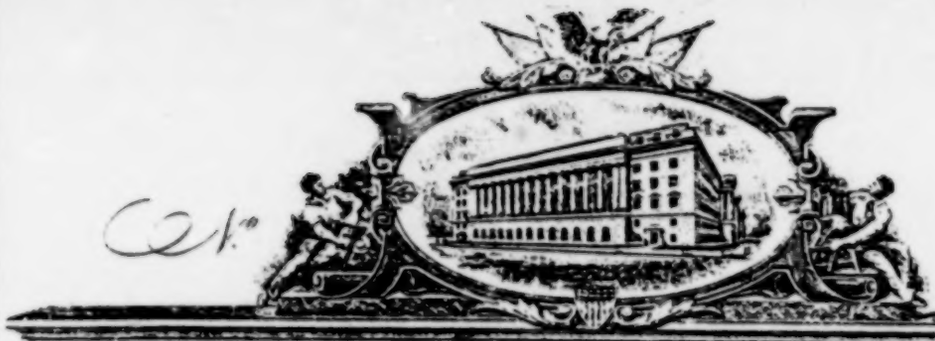
APPENDIX



3679512

THE UNITED STATES OF AMERICA

TO ALL TO WHOM THESE PRESENTS SHALL COME:

Whereas, THERE HAS BEEN PRESENTED TO THE

Commissioner of Patents

A PETITION PRAYING FOR THE GRANT OF LETTERS PATENT FOR AN ALLEGED NEW AND USEFUL INVENTION THE TITLE AND DESCRIPTION OF WHICH ARE CONTAINED IN THE SPECIFICATION OF WHICH A COPY IS HEREUNTO ANNEXED AND MADE A PART HEREOF, AND THE VARIOUS REQUIREMENTS OF LAW IN SUCH CASES MADE AND PROVIDED HAVE BEEN COMPLIED WITH, AND THE TITLE THERETO IS, FROM THE RECORDS OF THE PATENT OFFICE IN THE CLAIMANT(S) INDICATED IN THE SAID COPY, AND WHEREAS, UPON DUE EXAMINATION MADE, THE SAID CLAIMANT(S) IS(ARE) ADJUDGED TO BE ENTITLED TO A PATENT UNDER THE LAW.

NOW, THEREFORE, THESE **Letters Patent** ARE TO GRANT UNTO THE SAID CLAIMANT(S) AND THE SUCCESSORS, HEIRS OR ASSIGNS OF THE SAID CLAIMANT(S) FOR THE TERM OF SEVENTEEN YEARS FROM THE DATE OF THIS GRANT, SUBJECT TO THE PAYMENT OF ISSUE FEES AS PROVIDED BY LAW, THE RIGHT TO EXCLUDE OTHERS FROM MAKING, USING OR SELLING THE SAID INVENTION THROUGHOUT THE UNITED STATES.

In testimony whereof I have hereunto set my hand, and caused the seal of the Patent Office to be affixed at the City of Washington this twenty-fifth day of July, in the year of our Lord, one thousand nine hundred and seventy-two, and of the Independence of the United States of America the one hundred and ninety-seventh.

Attest:

Mary M. Gibson Jr.

Attesting Officer.

28r

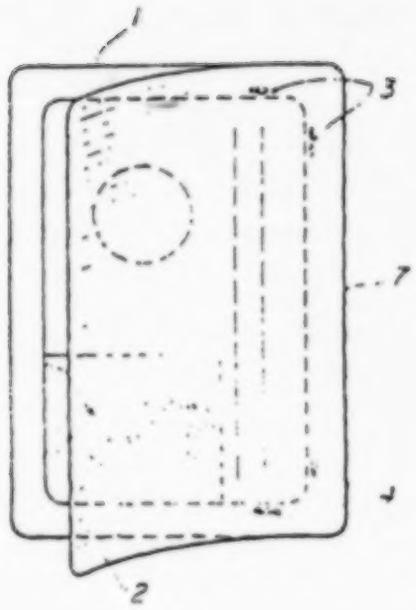
Commissioner of Patents.

(PART I)

July 25, 1972 F. W MACONE 3,679,512

LAMINATED CARD ENVELOPE

Original Filed April 19, 1967



FREDERICK W. MACONE
INVENTOR

By Robert J. Mattern
ATTORNEY

United States Patent Office 3,679,512
Patented July 25, 1972

3,679,512
LAMINATED CARD ENVELOPE

Frederick W. Macone, Carlisle, Mass., assignor to Avant Corporation, Lincoln, Mass.

Original application Apr. 19, 1967, Ser. No. 632,072, now Patent No. 3,526,567.
Divided and this application May 20, 1970, Ser. No. 39,035
Int. Cl. B32b *31/20*; G09f *3/02*
U.S. Cl. 156—272 2 Claims

ABSTRACT OF THE DISCLOSURE

This disclosure illustrates a novel envelope for receiving and properly orienting a data card positioned within the envelope which is thereafter subjected to heat and pressure to produce a composite, multilayered laminated card.

The present invention relates to a laminated card envelope for facilitating the manufacture of laminated cards.

CROSS REFERENCE TO RELATED APPLICATION

This application is a division of application Ser. No. 632,072, now Pat. No. 3,526,567, filed Apr. 19, 1967, assigned to the same assignee as the present invention.

BACKGROUND OF THE INVENTION

Laminated cards containing printed or pictorial data cards are usually produced by manually orienting the data card with respect to the inside faces of the larger outer plastic sheets which "sandwich" the data card. Generally it is desirable to manipulate the data card so that its edges are parallel to the edges of the outer plastic sheets and so that the border surrounding the data card is even or symmetrical. Often, before the composite card, bearing the centered data card, is exposed to heat and laminating pressure in the laminator the inner data card changes position to produce an unsightly card or even a ruined one where the data card extends beyond the edges of the outer plastic sheets. Additionally, a given pre-determined position of the inner card with respect to the outer plastic sheets is required if the laminated card is to be embossed or coded for automatic data processing reading equipment. The positioning of the inner data card is sometimes further impeded by a moist card (e.g., a photographic print not fully dried) sticking to the inside faces of the outer plastic cards. The envelope of the present invention is constituted so that a moist photographic print may be rapidly inserted and properly oriented without rubbing or being pressed against the inner faces of the plastic sheets which causes abrasion and consequent damaging of the moist emulsion surface. In any event, it is highly desirable, especially for rapid production, to provide means for rapidly and accurately positioning the inner data card with respect to the outer plastic cards in a manner which impedes shifting of the inner card before lamination.

SUMMARY OF THE INVENTION

In accordance with a preferred embodiment of the invention, first and second outer plastic sheets are heat sealed or spot welded to produce a pair of nests each consisting of orthogonally positioned elongated welds, separated by an amount substantially equal to a major dimension (length or width) of the inner data card. The welds or seals couple and maintain the outer sheets in a congruent relationship, while they act as nests to receive and properly orient the inner data card which may be inserted in a second or so. Since the nests lie just outside of the corner edges of the cards, they prevent a shift in card position before lamination.

SPECIFIC DESCRIPTION

The figure illustrates outer plastic cards 1 and 2, sealed or welded together by nests 3 and 4 each consisting of elongated, orthogonally positioned seals or welds. "L" shaped electrodes may be applied

to the congruent cards to heat seal or weld them as shown. The nests are preferably positioned just beyond the corner edges of the inner inserted data card 6 so as to "frame" the card and prevent the aforesaid shifting. The elongated welds or seals making up each nest need not actually intersect, and for that matter need not necessarily be elongated. The outer sheets may be completely separate before being coupled together by the seals or could be formed of a single double sized sheet of plastic folded along edge 7.

The folding of a double sized plastic sheet before insertion of the data card and lamination, with or without the aforesaid nests, is particularly suitable for very high mass production where the outer sheets need not be of different material. In the absence of nests and for certain applications, the fold itself acts to maintain the outer sheets in the proper relationship and may be used to orient the data card where a major dimension of the card, such as its length or width, is positioned against the fold. Also, this approach may be utilized in conjunction with a single spot weld or heat seal. In other words, the length of the card, for example, may be positioned against the fold and its width may be positioned against a single elongated or spot weld.

Obviously, many modifications and variations of the present invention are possible in the light of the above teachings. It is therefore to be understood, that within the scope of the appended claims, the invention may be practiced otherwise than as specifically described.

I claim:

1. A method of producing a laminated data card having a plurality of edges comprising the steps of:

(A) providing an envelope having:

(1) coupling means positioned between the inner heat activatable adhesive-bearing surfaces of a pair of outer sheets to be laminated together for maintaining said outer sheets in a congruent face-to-face relationship with each other;

(2) said coupling means being positioned with respect to said pair of outer sheets for permitting wide separation of major portions of the outer coupled sheets;

(3) said coupling means being positioned with respect to the edges of said pair of outer sheets for properly locating an edge of an inner data-bearing sheet inserted between said coupled outer sheets and abutting said coupling means;

(B) separating said other sheets along at least two adjacent edges to permit an inner data-bearing sheet to be easily and rapidly inserted between said outer sheets and gripped thereby;

(C) inserting an inner data-bearing sheet between said outer sheets and against said coupling means for accurately positioning an edge of said data-bearing sheet with respect to said outer sheets; and

(D) laminating said outer sheets and said inner data-bearing sheet together by the application of heat thereto.

2. The method of claim 1 wherein said coupling means is formed by heat sealing said first and second outer sheets together at widely separated portions of said outer sheets to provide for accurate alignment of the edges of said inner data bearing sheet with respect to the coupled outer sheets.

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U.S. Cl. X.R.

40—1.5, 2.2; 156—290, 293, 306; 283—7

Supreme Court, U. S.
FILED
AUG 25 1978
MICHAEL RODAK, JR., CLERK

IN THE

SUPREME COURT OF THE UNITED STATES

77-1837

October Term, 1977

AVANT INCORPORATED,

Petitioner,

v.

POLAROID CORPORATION,

Respondent.

REPLY OF AVANT INCORPORATED TO THE OPPOSITION BY POLAROID TO AVANT'S PETITION FOR CERTIORARI TO THE U. S. COURT OF APPEALS FOR THE FIRST CIRCUIT

Counsel of Record:

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REPLY OF AVANT INCORPORATED TO THE OPPOSITION BY POLAROID TO AVANT'S PETITION FOR CERTIORARI TO THE U. S. COURT OF APPEALS FOR THE FIRST CIRCUIT

Polaroid characterizes this as an ordinary patent case which does not warrant a review by this Court on the merits. To the contrary, this is a case in which a litigant has been deprived of a fair trial and the Courts below have displayed a complete failure to grasp the case and have enunciated unfounded theories of law which are completely without precedent. Such a case warrants review by this Court.

This reply will deal, in the first place, with the improper analysis of "synergy" by the Trial Court and the improper approval of that analysis by the Court of Appeals and will then deal, in a point-by-point rebuttal, with Polaroid's other arguments.

REPLY POINT I-A [to Opp. Brief, p. 19]

THE COURTS BELOW HAVE MADE AND APPLIED AN IMPROPER ANALYSIS OF "SYNERGY" WHICH HAS PREJUDICED PLAINTIFF

The five cases cited by Polaroid on page 19 of their Brief in Opposition completely fail to support their proposition that "A combination of old elements, whether embodied in a machine or a process, may not be patented if the combination does not produce a synergistic result." This is eloquently demonstrated by the analysis made by Judge Giles S. Rich,

Court of Customs and Patent Appeals, before the American Patent Law Association in Rochester, New York, in May, 1978:

"Most Patentable Inventions Are Combinations

"I deplore the quotation from A & P about the improbability of combinations of old elements being patentable inventions, of course, because practically all patentable inventions are combinations of old elements, as I expect the Supreme Court to acknowledge publicly some day because I believe it already recognizes that irrefutable fact. After all, it was just that which it held patentable in United States v. Adams, given the evidence to show unobviousness.

"Far from being an improbable place to find patentability, the new and unobvious combination is the usual place for finding it. This is a truism to any patent examiner or patent lawyer, but the Supreme Court hears patent cases so seldom as not to know it. Consider the telling sentence opening the opinion in Graham: 'After a lapse of 15 years the Court again focuses its attention on the patentability of inventions * * *.' That last focus was in A & P, decided almost two years before the effective date of the new patent act and its new section 103.

"The real flaw in the Supreme Court's opinion in Ag Pro is its apparently unthinking adherence to the outworn and unhelpful A & P requirement for 'invention,' after telling the world in Graham that Congress has 'emphasized 'non-obviousness' as the operative test,' which is 'the new statutory formulation to be approached by the three-step factual inquiry Graham dictates, 'strict observance' of which 'will result in that uniformity and definitiveness which Congress called for.' How can the Court expect the Patent and Trademark Office and the lower courts to follow its Graham directive that their inquiry as to patentability 'must be beamed with greater intensity on the requirements of § 103' when it illogically reverts, as it seems to do at the end of the Ag Pro opinion, to the antequated A & P 'invention' standard? Reason and logic cannot have it both ways.

"No Synergism Required by Ag Pro

"But the point I want to come to is: Did Ag Pro say or hold that synergism or a synergistic effect is essential to patentability? The answer is clearly 'No'.

"The Ag Pro Supreme Court was not responsible for injecting the notion of synergism into the case. It got it from the 5th Circuit of Appeals opinion, which in turn got it from an opinion in another 5th Circuit opinion

which got it from Black Rock. The lower court had said that Ag Pro's invention 'does achieve a synergistic result' and the Supreme Court said 'We cannot agree that the combination . . . can properly be characterized as synergistic, that is result(ing) in an effect greater than the sum of the several effects taken separately.' That is all it said. It simply expressed disagreement with the lower court's view that there was a synergistic result. It did not say there must be one."

REPLY POINT I-B [to Opp. Brief, p. 1]

POLAROID TO THE CONTRARY,
THERE IS A CLEAR CONFLICT OF DECISIONS

There is an evident conflict between the decision of the First District Court of Appeals and those decisions of the other Courts of Appeals regarding the requirements for patentability. This has been previously set forth in detail in Avant's Petition to this Court in Question #2. (NEW REQUIREMENT OF TOLERANCES) and in Question #3. (IMPROPER REQUIREMENT OF SUBJECTIVE CRITERIA).

REPLY POINT I-C [to Opp. Brief, p. 5]

POLAROID TO THE CONTRARY,
SIMPLICITY IN THE CIRCUMSTANCES OF THE PRESENT CASE MAKES A PRIMA FACIE CASE OF NON-OBVIOUSNESS

Polaroid succeeded in confusing the Courts below into equating simplicity with obviousness. Copernicus correctly postulated that the earth rotates around the sun, not vice versa. His explanation was simple, but it was not obvious.

In the case of the present invention, given its alleged simplicity, if in fact it were obvious, it would have been realized in the 30's, when the need for it arose, and Polaroid would not have found it necessary, as evidenced fully by the Record, to resort to a wide variety of other techniques before finally deciding in the late 60's to copy the invention after all of its other efforts had failed.

REPLY POINT I-D [to Opp. Brief, p. 4]

POLAROID TO THE CONTRARY, THE COURTS BELOW HAVE MADE A GROSSLY INCORRECT EQUIVALENCE BETWEEN HEAT LAMINATION AND PRESSURE LAMINATION THAT CAN ONLY BE ATTRIBUTED TO A FAILURE TO GRASP THE TECHNICAL SUBJECT MATTER BEFORE THEM

Laminating by heat and pressure without die-cutting as shown by the patent drawing and as taught in the claims of U. S. Patent No. 3,679,512, are not old. It is not proper to equate "heat" or "pressure," since lamination by pressure alone fails to produce a secure and tamperproof I.D. card, as Polaroid admits in its Rule 36 Admissions as follows:

"70. That the finished product could be at least partially delaminated by exposure to solvents (for example, gasoline).

"Response. Interpreting the request as relating to nondestructive delamination at the pressure-sensitive adhesive interface by exposure to some solvent, admits; otherwise, denies.

"71. That the finished product could be completely delaminated by exposure to solvents (for example, gasoline).

"Response. Same response as to Request 70."

REPLY POINT I-E [to Opp. Brief, p. 6]

POLAROID TO THE CONTRARY, THE INVENTION IS EMBODIED IN A LANDMARK PATENT

The Avant chip-bonding process did not attain "merely . . . a measure of success," it revolutionized the industry. Data submitted by Polaroid shows that during the first year after introduction by them (1971), chip-bonding was eleven times more successful in sales than their highly promoted pressure-sensitive laminating system called "Dual Bond" (introduced c1969), which is similar to the Dunn patent.

Furthermore in response No. 230 to Avant's Rule 36 Request for Admissions, Polaroid responded as follows:

"230. That normally after lamination of the inner card to the pouch, that the pouch is not subsequently placed in a die-cutter to further die-cut the laminated product.

"Response. Admits."*

Polaroid succeeded in confusing the lower courts as to the difference between commercial acceptability of slight adhesive ooze that doesn't require subsequent die-cutting and free-flow of plastic lamination into irregular unsightly edges, as shown in Avant's brief to the First Circuit Court of Appeals, page 20A, again reproduced in Appendix A.

This shows free-flowing ooze as against slight edge flash. As can be seen from Polaroid's Admission number 230 above, slight "flash" or ooze of adhesive is commercially acceptable and eliminates die-cutting, whereas free-flow oozing of the base plastic into irregular forms and wavy edges absolutely mandates post-lamination die-cutting of I.D. cards (unless a "molding" technique is used vis-a-vis "laminating"--which Polaroid does use in its "PolaPress" process to prevent the need for edge trim--see Question #8 [FAILURE TO GRASP TECHNICAL SUBJECT MATTER]).

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*The entire 336 Rule 36 Admissions were not admitted into evidence--see Question #11 (DEPRIVATION OF FAIR PROCEDURE) and page 12 of this Reply.

REPLY POINT I-F [to Opp. Brief, p. 15]

POLAROID'S "UNIMPEACHABLE PROPOSITION" ON LINEARITY IS COMPLETELY FALSE IN THE CONTEXT OF THE PRESENT INVENTION

Polaroid posited the Court of Appeals as espousing ". . . the obvious proposition that if one wants even edges one might logically start with even edges id at 891 (52a, 53b), an unimpeachable proposition established in the record practiced in the past, and fully in accord with common experience and straightforward logic."

When laminating under heat and pressure the above statement is false and reveals a failure to grasp the technical subject matter (Avant Question #8). It was graphically shown in this action how straight edges oozed into crooked and irregular edges in the Lapham laminating Instruction Book reproduced on page 14 of this reply. This phenomenon of straight edges laminating into crooked ones was exactly duplicated at the trial.

Furthermore, the Moulder patent (U. S. 2,294,796) cited as a reference by the U. S. Patent Office in the patent in suit (cited in Polaroid's reply brief page 31r) is based upon the principle that uneven edges before heat lamination become relatively even after lamination. (See Appendix B.)

This is why the subject invention's elimination of heat (high security) post-lamination die-cut trimming through

congruency produces such a non-obvious result, and why it has been so universally copied.

REPLY POINT I-G [to Opp. Brief, p. 13]

THE SECRET REFERENCE DUNN APPEARS TO BE ACKNOWLEDGED AS BEING OF DOUBTFUL VALUE TO POLAROID

The secret reference Dunn relied upon by the Courts below ". . .refers to a well-known prior art use of machine lamination involving heat" in a negative fashion by teaching away from the use of machines and high security. This may be why the first submission of brief in opposition by Polaroid included a page from the Dunn patent (page 32r), whereas the second version submitted to us omitted Dunn entirely. Polaroid's letter of transmission of the second brief version (received by Petitioner July 26, 1978) pointedly mentions the elimination of Dunn from its brief submitted to the Supreme Court by stating:

> "Your office was inadvertently served with three copies containing an extra page in the appendix, which page was not included in the copies filed with the Court."

REPLY POINT I-H [to Opp. Brief, P. 17]

POLAROID TO THE CONTRARY, THERE IS NO TEACHING OF CONGRUENT HEAT-ACTIVATED ENVELOPES IN THE PRIOR ART

Neither court below found that there were congruent heat-activated envelopes in the prior art. Both courts talk loosely about "roughly congruent plastic sheets." (Court of Appeals Opinion page 3, page 51 Avant Petition.) At no point during the trial or the briefs were congruent platen pouches shown. Both courts saw hundreds of congruent Avant chips and several Polaroid chips made that were congruent. At trial the detrimental effects of "roughly congruent", i.e., non-congruent, were graphically demonstrated before the judges versus the beneficial effects of congruency by actually laminating platen pouches and Avant chips on a c1963 platen press (Exhibits P-2 0 v. P-13, respectively). The non-congruent platen pouches oozed irregularly at least 1/4" to 1/2", which would have required post-lamination die-cutting or trimming. The Avant chips in the same machine, operated by Polaroid's own attorneys, produced perfectly saleable I.D. cards with minimal and even adhesive ooze or "flash" of no more than 1/64", which rapidly wears or peels off. Polaroid's Admission No. 220 to Avant's Rule 36 requests establishes that Polaroid has never required post-lamination die-cutting on any of its tens of millions of "PolaSeal" pouches, or chips, which are the subject of this infringement suit.

REPLY POINT II-A [to Opp. Brief, pp. 26 & 10]

POLAROID TO THE CONTRARY, THE FUNDAMENTAL PROCEDURAL ERRORS WERE RAISED BELOW, AND THE OTHER CUMULATIVE ERRORS ARE PROPERLY BEFORE THIS COURT

The matter of the missing portions of the trial record most favorable to Avant (Question #1.b.) and the lower court's arbitrary exclusion of Rule 36 Admissions by Polaroid (Question #11) were vigorously raised before the Court of Appeals.

Avant acknowledges that it would have been better had the actions of the trial judge in depriving it of a fair trial been brought to the attention of the Court of Appeals. However, it would appear that in view of the summary and arbitrary fashion that the Court of Appeals dismissed, without explanation, Avant's contentions regarding the Rule 36 Admissions that the other errors in procedure and deprivation of a fair trial would also have been summarily rejected by the Court of Appeals.

Moreover, although any one deprivation or any one procedural regulation taken by itself might not constitute a sufficient basis for an award of a new trial, Petitioner submits that the cumulative effect of a large number of procedural errors and deprivations do present, in justice, a case for a new trial.

REPLY POINT II-B [to Opp. Brief, p. 26]

THE FAULTY BASIS FOR THE POLAROID POSITION IS UNDERSCORED BY THEIR ATTEMPT TO CAPITALIZE ON A TYPOGRAPHICAL ERROR

Page 27 of Avant's Petition has a typographical error. The final sentence should read, "Their exclusion in the fact

of these circumstances is inconsistent with 'substantial justice' and does not constitute 'Harmless Error' under Rule 61 of the Federal Rules of Civil Procedure (Appendix E)."

REPLY POINT II-C [to Opp. Brief, p. 25 to p. 26]

POLAROID TO THE CONTRARY, THE "HAZELTINE" RULE IS IMPROPER

Polaroid correctly states that the Hazeltine rule is the present principle of patent law with respect to patent application disclosures. We submit that this rule is inconsistent with justice and common sense and should be overturned. We are not Medes and Persians.

REPLY POINT II-D [to Opp. Brief, p. 26]

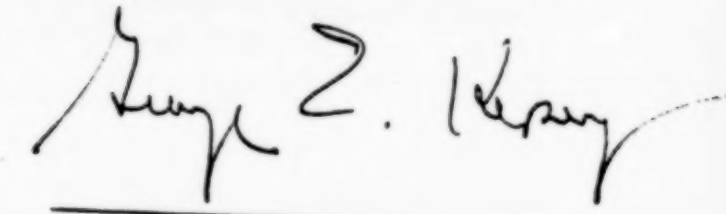
THE PROPRIETY OF THE RULE 36 ADMISSIONS

Essentially all the Rule 36 Request for Admissions by Avant were in the form of 336 questions filed with Polaroid on April 26, 1973, and answered by them within 60 days. Where Polaroid says ". . .that many of the Rule 36 materials in question were served on Polaroid on the eve of trial. . ." they are referring to minor items. The Rule 36 Admissions that were substantively vital to Avant and which we strenuously object to being excluded were served on Polaroid on April 26, 1973, 38 months before trial.

CONCLUSION

The Writ of Certiorari should be granted in all respects.

Respectfully submitted,



George E. Kersey
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Avant Incorporated
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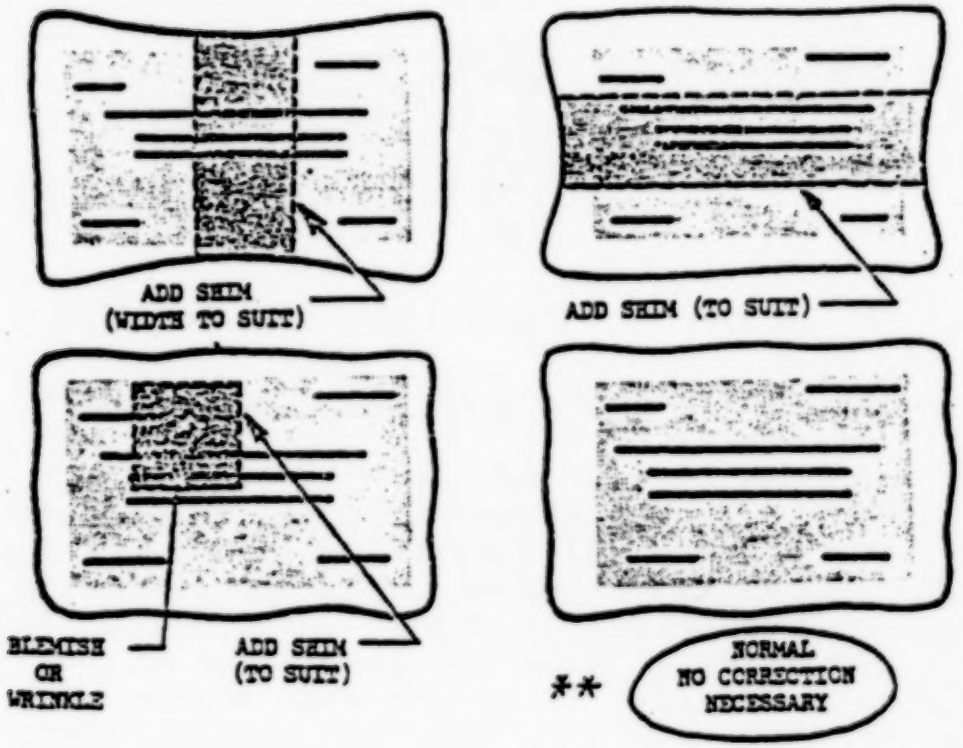
Tel. 617-259-9260

APPENDIX A

Partial Reproduction of Exhibit P-2A-7
Showing Defective and Normal Platen
Press Products according to Mr. Lapham,
AX37, L. 11-15



**Circularization for emphasis added

APPENDIX B

Sept. 1, 1942. L. W. MOULDER 2,294,796

PROTECTING COVER FOR CARDS AND METHOD OF PRODUCING THE SAME

Filed Dec. 31, 1940

Fig. 1.

Fig. 2.

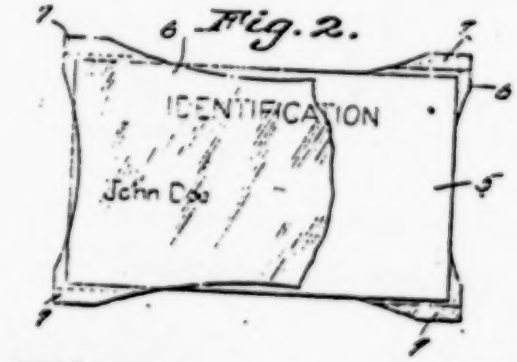


Fig. 3.

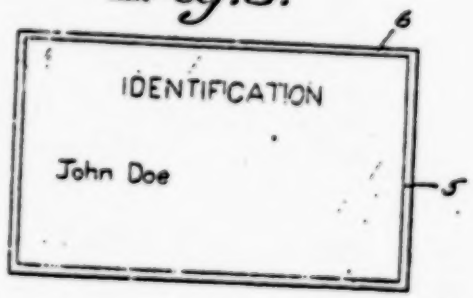


Fig. 4.

L. W. Moulder
INVENTOR.
BY C. A. Snow & Co.
ATTORNEYS.

CERTIFICATE OF SERVICE

I, George E. Kersey, Attorney for Petitioner, certify that three copies of the Reply of Avant Incorporated to the Opposition by Polaroid to Avant's Petition for Certiorari to the U. S. Court of Appeals for the First Circuit were served on the Respondent August 23, 1978, by mailing same first-class, postage prepaid, to Willkie Farr & Gallagher, Attorneys for Respondent, 1 Citicorp Center, 153 East 53 Street, New York, New York 10022.

George E. Kersey